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BEFORE THE

**Supreme Court of the United States**

OCTOBER TERM, 1944.

Nos **738**

MINNESOTA MINING & MANUFACTURING COMPANY, *Petitioner,*

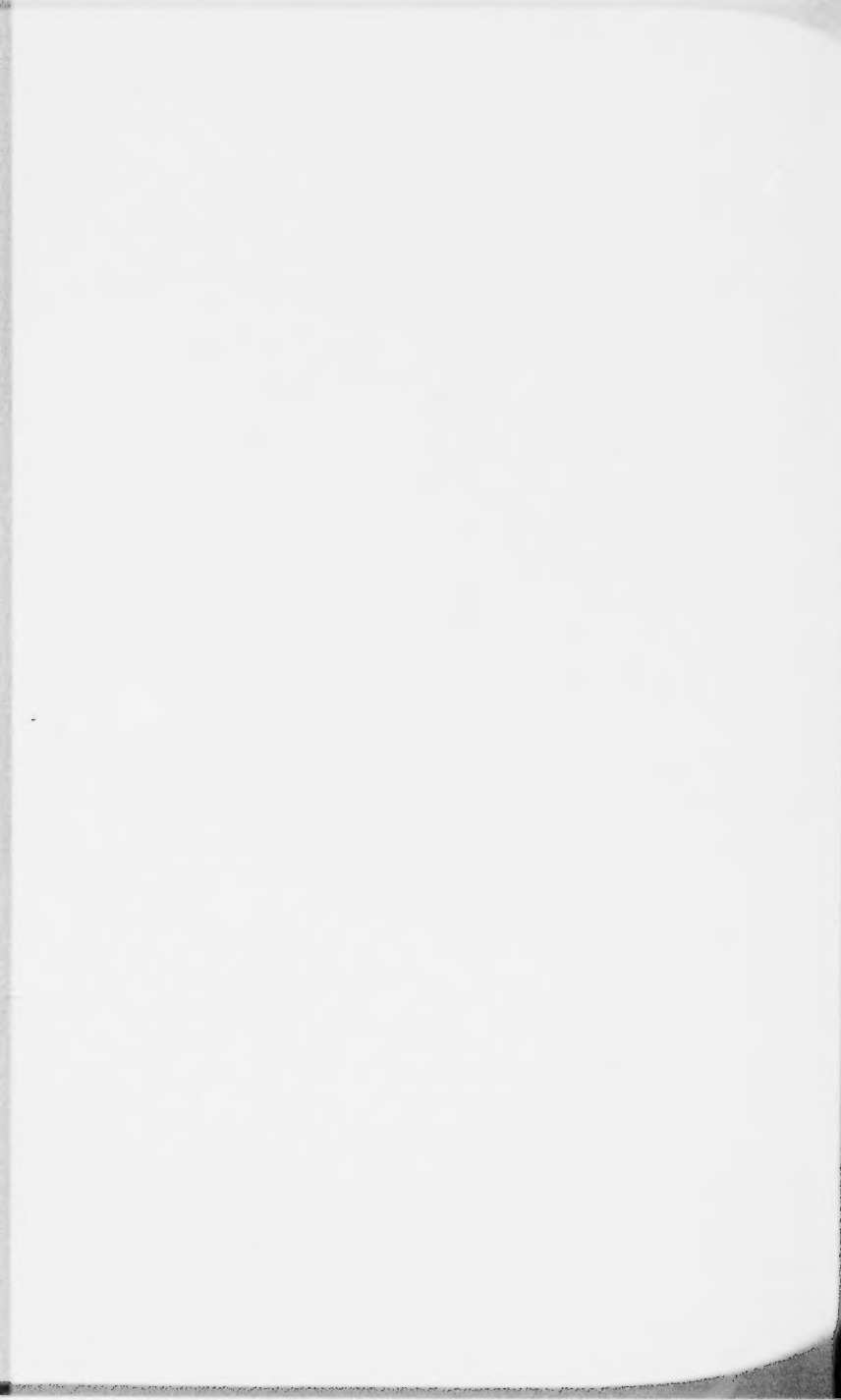
v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

**PETITION FOR WRITS OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA AND BRIEF IN SUP-  
PORT THEREOF.**

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**PETITION FOR WRITS OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA.**

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*To the Honorable, the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioner, Minnesota Mining & Manufacturing Company, by its undersigned attorneys, respectfully prays that writs of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgments of that court entered on July 10, 1944, affirming the dismissal of petitioner's bills of complaint in the above two closely related cases. (Said causes were consolidated for purposes of trial and for argument on appeal, and were decided in a single opinion, R. 417-19.) A petition for rehearing (R. 421) was filed within the time limit and was denied by the court on September 8, 1944 (R. 426). The transcript of the record, including the proceedings in the

said United States Court of Appeals for the District of Columbia, is furnished herewith in accordance with Rule 38 of this Court.

### **Short and Summary Statement of the Matter Involved.**

On December 1, 1933, Clifford L. Jewett, petitioner's assignor, filed an application for a patent in the United States Patent Office, Serial No. 700,632. The invention of the application concerns roofing granules having a very thin, weather-resistant colored coating firmly bonded to the surface of mineral base granules, so that the granules will maintain their color for long periods of time upon exposure to the atmosphere and will be free or substantially free of blooming, *i. e.*, unsightly white efflorescent salts.

The Examiner in the Patent Office rejected applicant's claims and his rejection was affirmed by the Board of Appeals, whereupon petitioner filed a complaint in the United States District Court for the District of Columbia under the provisions of Section 4915 of the Revised Statutes, U. S. C., Title 35, Section 63 (Appendix, pp. 37, 38), which action was given Equity No. 64,920. The district Court rendered a decision favorable to petitioner (see *Minnesota Mining & Mfg. Co. vs. Coe*, 28 F. Supp. 80 D. C., Dist. Col., 1939) and also made findings of fact and conclusions of law favorable to petitioner in that action on June 19, 1939 (R. 170-176).

In the meantime, namely, on January 3, 1939, the Commissioner of Patents granted to one Marion H. Veazey, on application filed later than Jewett, a patent, claims 8 and 9 of which are broader than, and fully dominate the claims which had been held patentable to Jewett by the district court.

When the Jewett application was returned to the Patent Office, following an allowance of the claims held patentable by the court, a petition for renewal was filed in accordance with settled law and practice and claims 8 and 9 of said

Veazey patent were asserted as claims 71 and 72 of said Jewett application (R. 25). The Examiner in the Patent Office finally rejected these claims, and also other claims in the application, except those which the court had held patentable, and his rejection was affirmed by the Board of Appeals of the United States Patent Office. The two claims of the aforesaid Jewett application S. N. 700,632 which correspond verbatim with claims 8 and 9 of the Veazey patent (R. 197), and which are numbered 71 and 72 (R. 25), as well as several other claims, were considered by the district court in Civil Action No. 13,832, timely brought under the provision of Section 4915 R. S., from which Appeal No. 8454 was timely taken and prosecuted. The district court's judgment was adverse to the petitioner (R. 159); and the affirming decision of the court of appeals (R. 417-419) was also unfavorable.

A related Jewett application S. N. 305,294, based largely on the earlier application S. N. 700,632, aforesaid, was filed in the Patent Office on November 20, 1939 and, following final rejection and appeal to the Board of Appeals, a complaint was filed under Section 4915 R. S., the cause being given Civil Action No. 8420, in respect to which an adverse judgment was rendered by the district court (R. 16) on the same day as in Civil Action No. 13,832, aforesaid. Civil Action No. 8420 came before the court of appeals as Appeal No. 8453, wherein the decision of the district court was affirmed in the aforementioned opinion (R. 417-19).

### **Questions Presented.**

The decision of the Court of Appeals for the District of Columbia raises the following questions of law:

#### **Question 1.**

Does Section 4915 R. S. (U. S. C., Title 35, Section 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an appli-

cant who has been refused a patent by the Board of Appeals, where, if the court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (see R. S. 4915 at Appendix, pp. 37, 38).

### Question 2.

In Section 4915 R. S. (U. S. C., Title 35, Section 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . .", does the word "or" mean "and", whereby action by both boards must precede applicant's right to the remedy provided?

### Question 3.

In an action brought by an applicant for a patent under Section 4915 R. S. (U. S. C., Title 35, Section 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the court holds for the applicant?

### Question 4.

Can the Court of Appeals for the District of Columbia, in an action brought by an applicant under Section 4915 R. S. involving claims copied from the patent of another granted on a later filed application, refuse to rule on the question of support for said claims in the application in issue, when the Patent Office has held the claims to be patentable and the question of support in appellant's application is the only issue directly raised by the appeal?

Questions 1, 2 and 3 are presented in precisely the same form as they were presented in *The Hoover Company vs. Coe*, Petition No. 486, in which a writ of certiorari was granted by this Court on November 6, 1944. The court of appeals decided *the Hoover case* on the same day as these cases, viz. July 10, 1944.

### Reasons Relied Upon for the Allowance of the Writs of Certiorari.

The discretionary power of the Court is invoked upon the following grounds:

1. **The main questions of law presented are precisely the same as those presented in *The Hoover Company vs. Coe*, Petition No. 486, in which this Court granted a writ of certiorari on November 6, 1944.**

The decision of the United States Court of Appeals for the District of Columbia (R. 417-19) was held up for a longer period than usual, and the court's decision herein was rendered on July 10, 1944, *i. e.* on the same day as the court's decision in *The Hoover Company vs. Coe*, which latter was decided after the court had set it for reargument on substantially the questions presented as 1, 2 and 3, hereinabove. The *Hoover Company* decision is cited in the footnote to the court of appeals' decision in the present case (R. 418). The facts here presented are on all fours with the facts of the *Hoover case*; this is indicated by the petition of the Hoover Company.\* The decision of the

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\*At pages 25 and 26 of the Hoover Company's brief in support of their petition, it is stated:

"... because of the facts in the *Minnesota Mining Co.* case which it specified and which are on all fours with the facts in the instant case. In the instant case, as in the *Minnesota Mining Co.* case 'a few' (one) of the claims were copied from an application (the Bergholm patent) . . . which was filed . . . later than the original Hoover application . . . In the Hoover case, as in the Minnesota case, 'it may be' that 'the record contains enough evidence to

Supreme Court in the *Hoover Company* case, if favorable to that petitioner, will show that the judgment of the court of appeals in the instant causes was erroneous.

It is believed that the present causes, in respect to the questions here presented, could properly be set for argument concurrently with *The Hoover Company vs. Coe*.

**2. The questions of law presented depend upon the construction of a United States statute and are of great public importance.**

The United States Court of Appeals for the District of Columbia, in denying the jurisdiction of the district court, has raised several questions of general importance relating to the construction of a statute of the United States *i. e.* Revised Statute, Section 4915, as amended by Act of August 5, 1939 (Appendix, pp. 37, 38). That statute provides for an action by bill in equity whenever a patent is refused by the Board of Appeals of the Patent Office.

The questions potentially affect the right of every applicant for a patent to the relief provided by law from an unjust refusal of a patent in the Patent Office. The facts of the present case are on all fours with the facts presented in *The Hoover Company vs. Coe* (144 F. (2d) 514, Ct. App. D. C., July 10, 1944) decided the same day by the same court. The mention of a *possibility* of a difference, given in the footnote to the court's decision (R. 418), resulted from the court's statement, "It is *not clear*,"\* *etc.* Actually there is no distinction.

The Rules of Practice in the United States Patent Office are inconsistent with the requirements of the lower court and make impossible the prerequisite to its jurisdiction

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show that the plaintiff (Hoover) was prior in time without the necessity of further interference proceedings.' In the Hoover case as in the Minnesota case 'the appeal (a 4915 action in each case) involves a number of similar claims which were not copied.' "

\*Italics supplied throughout unless otherwise noted.

which it demands. The statutory duty placed upon the Commissioner of Patents in Section 4904 R. S. also makes it impossible for the required prerequisite to be present.

**3. The questions of law presented have not been, but should be, decided by this Court.**

The questions of law presented have not been considered by this Court but the decision of the Court of Appeals for the District of Columbia represents a departure from established practice as set forth by that court in *Pitman v. Coe* (68 F. (2d) 412, Ct. App. D. C., 1933). For the first time an applicant for a patent is denied the relief provided by Section 4915, R. S., because of what the Patent Office may subsequently do, should the applicant prove himself entitled to a favorable decision. The decision is inconsistent with this Court's views as expressed in *Gandy v. Marble* (122 U. S. 432, 1887). The decision is in direct conflict with the same court's decision upon the question of jurisdiction in *Thorne, Neale & Co. v. Coe*, (143 F. (2d) 155, Ct. App. D. C., June 19, 1944) decided after the present cases were argued and a few weeks prior to the decision in the present cases.

As the Commissioner of Patents has his official residence in the District of Columbia, and as today all suits of an *ex parte* nature in which he is named as the sole party defendant are necessarily brought in the District of Columbia, it is entirely unlikely that these questions will be raised in cases arising in other jurisdictions (*Butterworth v. Hill*, 114 U. S. 128, 1885). However, under a discarded practice in which in such cases the Commissioner of Patents accepted service in jurisdictions other than the District of Columbia, the Circuit Court of Appeals for the Second Circuit in *Gold v. Newton* (254 F. 824, CCA2, 1918) followed a contrary practice, the question of jurisdiction being in issue.

The law announced in *Hoover v. Coe* and in the concurrent decision in the instant cases has been cited as controlling by

the Court of Appeals for the District of Columbia in other cases, *viz.*, *Line Material Co. v. Coe*, (62 USPQ 120, Ct. App. D. C., July 10, 1944) and *The Colgate-Palmolive-Peet Co. v. Coe* (62 USPQ 121, Ct. App. D. C., July 10, 1944).

**4. The court of appeals has not given proper effect to applicable decisions of this Court.**

The court below denied that a suit under Section 4915 R. S. (Appendix, pp. 37-38) was a proper method of reviewing an administrative ruling in a case where plaintiff's right to a patent cannot be determined, free of the possibility of a subsequent interference in the Patent Office.

This Court in *Steinmetz v. Allen* (192 U. S. 543, 1904) held that the requirement of "division" made by the Examiner without action upon all the merits of Steinmetz's case was "final and appealable".

This Court in *Frasch v. Moore* (211 U. S. 1, 1908) recognized the right of an applicant to bring a bill in equity under Section 4915 R. S. where the refusal of the patent was based upon a requirement for division with which the applicant refused to comply.

**5. The judgment and opinion of the court of appeals in the Hoover case and in the present case may seriously hinder and confuse the future administration of the law by the Patent Office, particularly with respect to Revised Statute 4904.**

This reason is believed alone to be adequate to support the granting of the petition (*Federal Trade Commission v. American Tobacco Co.*, 274 U. S. 543, 1927).

Section 4904, Revised Statutes, as amended by Act of August 5, 1939 (Appendix, p. 36), provides that the Commissioner of Patents shall direct the setting up of an interference "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere

with any pending application, or with any unexpired patent to determine the question of priority of invention." The setting up of the interference is, as noted, made dependent upon the "opinion of the Commissioner" and is not mandatory.

In conformance with Section 4904 R. S. (Appendix, p. 36), Rule 94 of the Patent Office (Appendix, pp. 40, 41) provides for interferences when the claims which recite the common invention "are allowable in the application of each party," or, when a patent and an application are involved, when the claims "are allowable in all of the applications involved".

The decision of the court of appeals requires, in order for an applicant for a patent to be entitled to the relief provided by Revised Statutes, Section 4915 (Appendix, pp. 37, 38), that the Commissioner set up an interference even though he is of the opinion that the claimed subject matter is not allowable in all the applications.

If the Commissioner is not to deprive applicants for patents of their rights as provided by Revised Statutes, Section 4915, then he must, under the decision of the court below, set up interferences when in his opinion none properly should be contested. The function is administrative and properly lies entirely within the Commissioner's discretion.

WHEREFORE your petitioner respectfully prays that writs of certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding the said court to certify and send to this Court on a day designated a full and complete transcript of the record and all proceedings in the court of appeals had in these consolidated causes, to the end that the same may be reviewed and determined by this Court; that the judgments of the said court of appeals

be reversed; and that said petitioner be granted such other and further relief as may be deemed proper.

MINNESOTA MINING & MANUFACTURING COMPANY,  
*Petitioner.*

By HAROLD J. KINNEY,

*Attorney for Petitioner.*

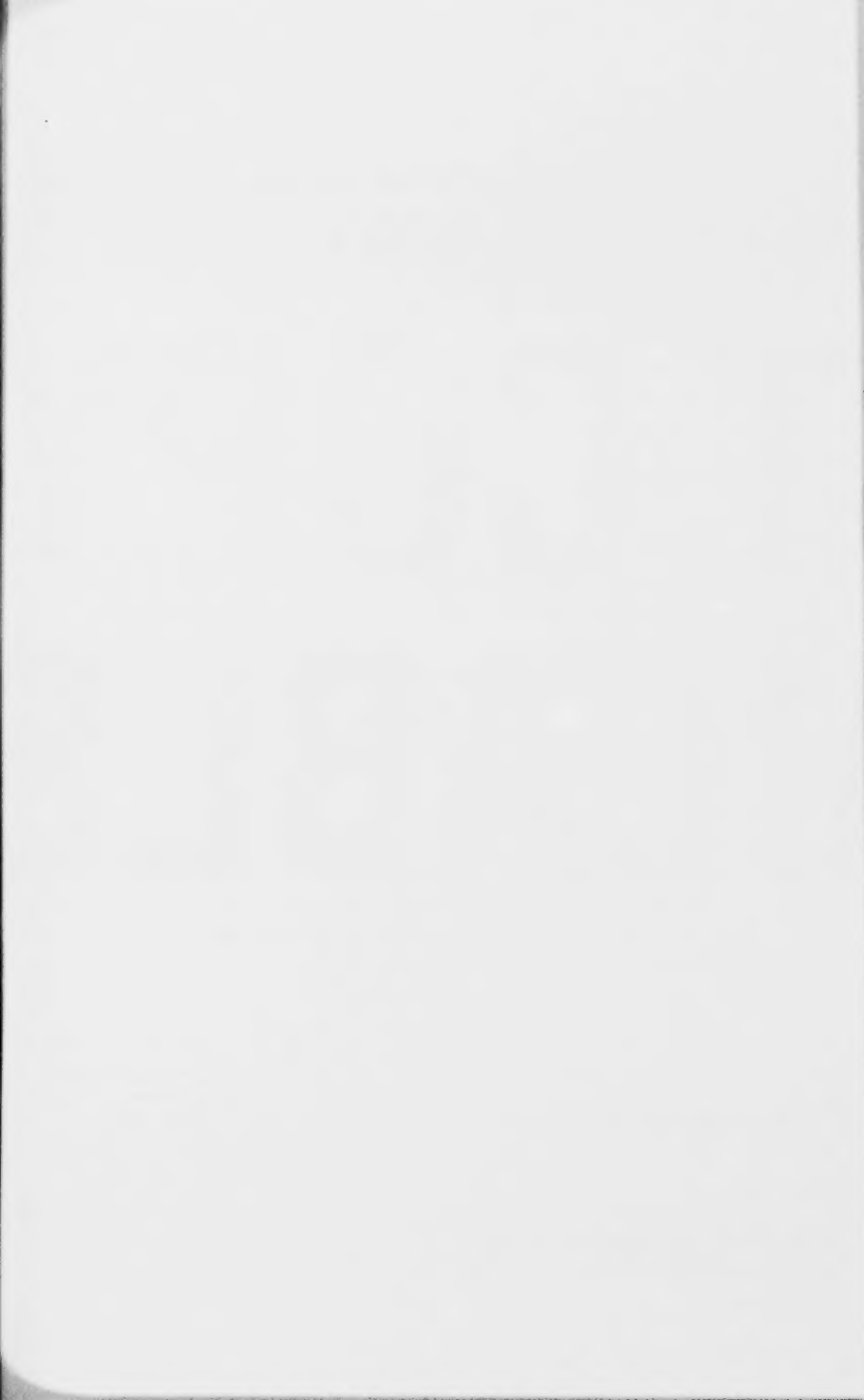
CHAS. S. GRINDLE,

*Of Counsel.*

I hereby certify that I have read the foregoing petition for certiorari, and that in my opinion it is well founded and presents grounds whereon the prayer ought to be granted, and I further certify that it is not intended for purposes of delay.

HAROLD J. KINNEY,

*Attorney for Petitioner.*





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**BRIEF IN SUPPORT OF PETITION FOR WRITS OF  
CERTIORARI.**  

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**The Opinion of the Court Below.**

The opinion of the Court of Appeals for the District of Columbia is reported at F. (2d) , 62 USPQ 119, and appears in the record filed herewith (R. 417-19).

**Jurisdiction.**

The grounds on which the jurisdiction of this Court is invoked follow:

(1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgments of the United States Court of Appeals for the District of Columbia were entered on

July 10, 1944, and its decision denying petitioner's petition for rehearing therein was rendered on September 8, 1944.

(3) The foregoing judgments were entered on appeal from judgments by the District Court for the District of Columbia in two civil actions brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent or patents to petitioner as assignee of the application of Clifford L. Jewett, Serial No. 700,632, filed December 1, 1933, and of the further, related application of Clifford L. Jewett, Serial No. 305,294, filed November 20, 1939.

(4) Some of the previous decisions of this Court which are believed to sustain jurisdiction in this case are:

*Gandy v. Marble*, 122 U. S. 432.

*Butterworth v. Hill*, 114 U. S. 128.

*Steinmetz v. Allen*, 192 U. S. 543.

*American Steel Foundries v. Robertson*, 262 U. S. 209.

*The Hoover Co. v. Coe*, Petition No. 486 (granted November 6, 1944).

### **Statement of the Case.**

The facts are set forth in the petition.

### **Specification of Errors.**

The errors which the petitioner will urge, if the writs of certiorari are issued, are that the Court of Appeals for the District of Columbia erred:

(1) In affirming the dismissal of petitioner's bill of complaint, upon the grounds that the district court had no jurisdiction under the provisions of Section

4915 R. S., or, alternatively, in failing to rule on the main issue thus presented by the appeal.

(2) In holding, contrary to past practice, that petitioner was not entitled to relief under the provisions of Section 4915 R. S. after having been refused a patent by the Board of Appeals and because he had not established priority over another, *i.e.* Veazey (R. 193, 197), claiming the same invention, the Patent Office (contrary to its long established practice) having refused to set up an interference to determine the question of priority after having been requested to do so by petitioner.

(3) In holding, as it also did in *Hoover v. Coe, supra*, and contrary to past practice, that petitioner is not entitled to relief under Section 4915 R. S. because a third party, who was not an adverse party to petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to petitioner by the Board of Appeals of the Patent Office but no interference or decision by the Board of Interference Examiners.

(4) In refusing or failing to decide the case upon its merits, and on the basis of the main issues directly raised by the appeal, and instead failing to decide the main issue and dismissing upon the grounds of lack of jurisdiction.

### **Highlights Of Pertinent Facts.**

The Court of Appeals, D. C., in the instant causes, as in the *Hoover case*, 144 F. 2d 514, has held that it does not have jurisdiction to rule on the question of support in the Jewett application Serial No. 700,632, here in issue, for the two claims copied from the Veazey patent, aforementioned. The claims copied from the Veazey patent had been

allowed to Veazey as a result of a decision of the Board of Appeals of the Patent Office and Veazy's application was filed in the Patent Office approximately eight months later than the filing date of petitioner's assignor. The Commissioner of Patents has held the two claims to be patentable, and they are presently extant in the Veazey patent, and the issue presented to the court of appeals in the instant causes was the question of support, in the Jewett application Serial No. 700,632, for claims 8 and 9 of the Veazey patent (R. 197), which are claims 71 and 72 of said Jewett application (R. 25). On the basis of the trial court's findings (R. 170-175) in the earlier R. S. 4915 action involving the same Jewett application Serial No. 700,632 (especially see paragraph 6 of said findings) it has been, in effect, fully adjudicated that the Jewett invention responds to, and the Jewett application supports the two claims copied from Veazey; and the decision of the district court (Judge McGuire) in Civil Action No. 13,832 (R. 158-9) is logically irreconcilable with the final and unappealed judgment of the same court (Judge Luhring) (R. 170-6) in the earlier R. S. 4915 action involving the same Jewett application, and the Court of Appeals D. C. failed and refused to resolve this conflict and disposed of the appeal on the basis that it and the district court (Judge McGuire) were without jurisdiction to decide the question of support for the claims copied from the patent, when it was "*not clear*" that a subsequent interference might not be necessary in the event of a favorable decision by the court.

### **Summary of Argument.**

For upwards of fifty years it has been accepted law and practice that a decree entered by a court of equity in an action under Section 4915 R. S. was not so far conclusive upon the Commissioner of Patents that upon the filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as di-

rected. The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law.*" The action of the court below, in refusing to take jurisdiction and decide the issues presented, even though an interference might and undoubtedly would be set up between the Jewett application and the Veazey patent, aforementioned, is inconsistent with the language of this Court in *Gandy v. Marble*, 122 U. S. 432, 440:

"\* \* \* All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

One of the other "requirements of law," contemplated by this statute, is that set out in Section 4904 R. S., U. S. C. Title 35, Section 52 (Appendix p. 36), wherein the Commissioner is directed to institute procedure for determining the question of priority between the "applicant and patentee."

The question of the district court's jurisdiction depends upon the construction of Section 4915 R. S. and is of great public importance.

This Court has not ruled upon the question of the district court's jurisdiction of an action brought under Section 4915 R. S. in a case in which, following a decision favorable to the complainant, further prosecution might take place in the Patent Office, and the decision of the Court of Appeals for the District of Columbia has not given proper effect to the applicable decisions of this Court.

The judgment and opinion of the court of appeals holding that that court has no jurisdiction of an action brought

under Section 4915 R. S. *unless its judgment may be made final and binding upon the Commissioner of Patents* may seriously hinder and confuse the administration of the law in the Patent Office, particularly with respect to Section 4904 R. S. (Appendix p. 36). The provision in Section 4915 R. S. of a "remedy by bill in equity" \* \* \* "whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners," provides for remedies under two separate conditions.

In an action brought under Sec. 4915 R. S. by an applicant against the Commissioner of Patents, after refusal of a patent by the Board of Appeals, a third party (patentee) claiming the same invention is not a necessary party where no interference between the application and the third party's patent was instituted by the Patent Office.

### Argument.

1. **The facts of this case are on all fours with the facts in the Hoover case and, in view of the prior decision of the District Court in respect to Petitioner's Application, in a sense presents an even stronger factual situation.**

In view of paragraph 6 of the findings of the district court (Judge Luhring) in the R. S. 4915 action involving the same Jewett application Serial No. 700,632, it has, in effect, been adjudicated that the operation of the process of the Jewett invention responds to and infringes, and hence the application defining the same *supports*, claims 8 and 9 of the Veazey Patent No. 2,142,540 (R. 197) which have been copied into the said Jewett application as claims 71 and 72 (R. 25). Jewett filed his application on December 1, 1933, whereas Veazey filed his application on July 31, 1934 (about eight months later), as shown by the patent (R. 193). The court of appeals states, as a truism, that if a mistake was made by allowing the claims to Veazey it would not help matters to perpetuate the mistake by allowing the same

claims to Jewett. But the Commissioner has not challenged the validity of these claims in the Veazey patent, and it follows that they would be *a fortiori* allowable in the Jewett application, filed eight months earlier than Veazey's filing date. These claims remain outstanding and presumptively valid in the Veazey patent. Lacking a holding by the court of appeals that claims copied from a patent are unpatentable, the court should rule directly on the question of support; and where it finds that the claims are supported by the application of the appellant, then the Commissioner may, upon the appellant's "filing in the Patent Office a copy of the adjudication" take appropriate action under Section 4904 R. S. to set up an interference, as provided by Section 4915 R. S., as a part of requiring the applicant *otherwise to comply with the requirements of law*, and the Commissioner may or may not subsequently issue a patent to the applicant, depending upon whether he is satisfied that the applicant has *otherwise complied with all the requirements of law*. But the court of appeals should decide the appeal on the basis of the issues presented, and should not refuse to decide the question of support in the application of the appellant, and should not dispose of the appeal simply by conjecturing that the claims copied from the patent might conceivably be invalid, when the claims remain outstanding and presumptively valid in the patent of another and later applicant.

## 2. The importance of the questions presented.

Ever since *Gandy v. Marble*, 122 U. S. 432, it has been accepted practice that a decree entered by a court of equity in an action under Section 4915, Revised Statutes, was not so far conclusive upon the Commissioner of Patents that upon filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as directed.

The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office

a copy of the adjudication *and otherwise complying with the requirements of law,*" and construing this language in *Gandy v. Marble*, this Court said (p. 440):

"\* \* \* All that the court which takes cognizance of the bill in equity, under Section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

In view of the foregoing decision, as well as the clear language of the statute, the right of the Commissioner of Patents to refuse to execute the decree entered in a 4915 action, if the successful plaintiff fails to pay the fees required by law or to meet other conditions required of him by the patent statutes and the rules of the Patent Office, cannot be challenged. Similarly the decree for all practical purposes is rendered a nullity where, after its filing, the Commissioner of Patents, while preparing to issue a patent, discovers the pending application of another claiming the same subject matter and is consequently required by law to declare an interference. It clearly appears from the memorandum which was presented by respondent to the court below in the *Hoover* case, that the administrative practice of the Patent Office consistently pursued throughout the years was admittedly contrary to the practice now dictated by the instant decision. By way of aiding the court below in its construction of the statutes involved, respondent informed the court of the existence of an administrative interpretation of long standing that, upon the filing of an adjudication favorable to an applicant, the Patent Office claimed the right to exercise, and did actually exercise, its prerogative "to proceed in accordance with other sections of the patent statutes." It was pointed out to the court that while the language of Section 4915 might appear to make the

adjudication mandatory and immediately effective, it was thought "that it is proper to consider it as a part of the entire patent law and hence co-ordinate with Section 4904 R.S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application, or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant that such a conflict exists. Therefore, when it is determined by the adjudication of the court that the conflict exists, Section 4904 R. S. comes into play and the interference must be declared, notwithstanding the form of the judgment." \*

In the face of this administrative interpretation by the Commissioner of Patents, and despite these unambiguous representations by him that no practical obstacles have been or are presented by a decree adjudging that an applicant is entitled to receive a patent, the court below nevertheless refused to assume jurisdiction of an action under Section 4915 in respect to the main issues herein because it considered that its decree could not be immediately carried out, but instead would result in an interference. The court below, holding that it was powerless to determine petitioner's "right to a patent" because it involved deciding

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\*Respondent in the *Hoover* case called attention to the fact that, under prevailing administrative practice, interferences have been declared by the Patent Office upon the filing of an adjudication that an applicant was entitled to receive a patent. Thus the court was informed that, after the decree entered in *Tully v. Robertson*, 19 F. (2d) 954, where the right of an applicant to copy claims from an unexpired patent and thus provoke an interference had been upheld, the interference was declared, notwithstanding the adjudication in favor of the plaintiff. Attention was specifically called to *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, and *American Cyanamid Co. v. Coe*, 106 F. (2d) 851. In those cases, after the dissolution of interferences set up by the Patent Office, the applicants on the *ex parte* prosecution of the application were refused certain claims on the ground of estoppel. Actions under Section 4915 were successfully prosecuted and upon the filing of the favorable adjudications the interferences were re-declared and prosecuted to decision.

that he is prior to another applicant,—not before the court—concluded, in effect, that the “whole controversy” had not been presented and that consequently there was no jurisdiction.

Thus not only is the question decided by the court below of general importance, but it is one of substance relating to the construction of statutes of the United States which has not been, but should be, settled by this Court. We respectfully submit, moreover, that the court below has not given proper effect to applicable decisions of this Court and that the instant decision, if erroneous, will produce unfortunate consequences in practice.

In *Butterworth v. Hill*, 114 U. S. 128, it was held by this Court that an action under Section 4915 may not be maintained against the Commissioner of Patents without his consent, where he is the sole defendant, save in the district of his official residence, and consequently it is within the power of respondent to require that all actions by applicants to whom patents are refused in *ex parte* cases be brought in the District Court for the District of Columbia. Hence the nature of the questions presented and the improbability that other inferior courts will ever have an opportunity to pass upon these identical questions should move this Court to grant the instant petition (cf. *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47; *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126).

3. **The decision below is contrary to the clear and unambiguous language of the statute and is in conflict with a liberal legislative policy calculated to afford applicants for patents ample remedy by a suit in equity in every case where a patent is refused.**

The enactment now found in the statutes of the United States on the subject of the availability to a defeated applicant for a patent of a remedy by suit in equity is the result of a long course of legislation. A review of this background

plainly reveals a liberal legislative policy inconsistent with the narrow and restricted view which was taken by the court below. However plausible Judge Arnold's arguments may be, the construction imposed by him upon the statute involved does not square with the words actually used in the statute and is in obvious conflict with its general Congressional purpose.

The first legislation dealing with a suit in equity by an applicant who had been refused a patent is found in the Patent Act of 1836. (Act of July 4, 1836, ch. 357, 5 Stat. 117) (Appendix pp. 32, 33).

By Section 7 of that Act the Commissioner of Patents was authorized, on the filing of an application for patent, to make an examination of the alleged new invention or discovery and it was declared to be his duty to issue a patent if he "shall deem it to be sufficiently useful and important"; in case of the Commissioner's refusal to issue a patent, the applicant was secured an appeal from this decision to a board of examiners. The decision of this board being certified to the Commissioner, it was declared that "he shall be governed thereby in the further proceedings to be had on such application."

By Section 8 it was provided that if in the opinion of the Commissioner an application "would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted" he was authorized, after notice to the parties, to decide the "question of priority of right or invention." An appeal to the board of examiners as in the case of other refusals was provided in these cases of interference.

Section 16 of the Act\* (Appendix p. 33) provided, in part:

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\*It should be mentioned that this section also related to a suit in equity "whenever there shall be two interfering patents." The proceedings were separated by the Act of 1870 (C. 230, 16 Stat. 198, Sections 52, 58). Actions relating to interfering patents are now covered by Section 4918 (35 U. S. C. Section 66).

“That \* \* \* whenever a patent on application shall have been refused *on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted*, \* \* \* any such applicant \* \* \* may have remedy by bill in equity, and the court having cognizance thereof \* \* \* may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention as specified in his claim, or for any part thereof, *as the fact of priority of right or invention shall in any such case be made to appear.* \* \* \*”

It will thus be observed that as enacted this section limited the “remedy by bill in equity” to cases of interference. The right of an applicant to appeal to the courts to review the action of the Patent Office was available only when the application had been refused “on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted.” In all other cases the decision of the board of examiners was final. No provision had been made for an independent judicial review in those cases.

By Section 10 of the Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353) (Appendix pp. 33, 34), the provisions of Section 16 of the Act of 1836 were extended to *all cases* where patents were refused “*for any reason whatever*,” either by the Commissioner of Patents or by the Chief Justice of the District of Columbia,\* upon appeals from the decisions of the Commissioner, “as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent.”

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\*By Section 11 it was provided that in all cases where an appeal was then allowed by law from the decision of the Commissioner of Patents to a board of examiners, an applicant, instead thereof, should have a right of appeal to the Chief Justice of the District Court of the United States for the District of Columbia.

Thus there was evinced by Congress more than a century ago an intention to make available to persons seeking patents the right to secure, by bill in equity, an independent judicial review in all cases where the Patent Office had refused a patent *for any reason whatever*. It would seem that all argument might therefore well close here, for only compelling language could justify a conclusion that Congress intended to abandon its avowed policy and, as will presently appear, no subsequent enactment of Congress has taken away any of the comprehensive power clearly conferred upon the courts at that early date.

By the Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198) (Appendix pp. 34, 35) the provisions of Section 16 of the Act of 1836 and of Section 10 of the Act of 1839 were combined into Section 52 of that Act, as follows:

“Section 52. *And be it further enacted*, That whenever a patent on application is refused, *for any reason whatever*, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, *as the facts in the case may appear*.\* And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law.”

In view of the language of the prior enactments and especially in view of the provision in Section 52 of the Act

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\*The italicized words constitute a broadening and significant departure from the limited language of the predecessor statute, *i. e.*, “as the fact of priority of right or invention shall in any such case be made to appear.”

of 1870 that the remedy by bill in equity was available in the case of a refusal "for any reason whatever," a Congressional purpose in favor of the applicant in all cases, far from being shown to have receded, is clearly carried forward. The right to a "remedy by bill in equity" in all cases was thus emphasized once more.

When the statutes were revised in 1874, we find that the words "for any reason whatever" appearing in Section 52 of the Act of 1870 were omitted from Section 4915 (Act of June 22, 1874, Section 4915); but certainly no one will contend that there is any difference between the words "*refused* for any reason whatever," as was provided in the Act of 1870, and the word "*refused*," as specified in Section 4915. It must be conclusively presumed that the revisers of the statutes recognized the equality of the expressions. It cannot be implied that any detracting of the right to a "remedy by bill in equity" was intended or that any decrease in the jurisdiction of the courts to make an independent judicial review flows from the deletion of the words "for any reason whatever."

If, originally, jurisdiction was conferred upon the courts solely for the purpose of reviewing and correcting refusals based on account of interference with a previously existing patent, and if such jurisdiction was subsequently extended to *all cases* where patents had been refused "for any reason whatever," we can see no justification for now holding that the Federal Courts have no jurisdiction because the issue of priority between an applicant and an existing patent is not also presented for determination. Such an issue was the only one which originally could have invoked the remedy by suit in equity, but the jurisdiction of the courts was subsequently expanded to apply to refusals on other grounds, and it does violence to a clearly expressed legislative policy to hold, as did the court below, that jurisdiction is wanting merely because the priority issue as between the applicant and a known unexpired patent is not presented.

There is no difference in principle between an action under Section 4915 followed by a declaration of an interference between the successful plaintiff and an applicant not previously known or contemplated and an action which is avowedly prosecuted in order to lay the foundation for the declaration of an interference with an existing patent with which the defeated applicant desires to contest priority. In the former case, the courts admittedly have jurisdiction. No decision—prior to that of the court below—has questioned the right of a person seeking a patent to prosecute a bill in equity in the latter case.

Orderly procedure dictates, contrary to the views of the court below, that where an interference with an unexpired patent is being provoked, the prior patentee should not be required to litigate until the defeated applicant has established his right to the claims and to an interference. Thus in *Robinson on Patents* (Vol. 2, Section 722, p. 463), that eminent patent law authority, commenting upon the separation by the Act of 1870 of proceedings involving interfering patents and those involving an applicant and a patent, said:

“\* \* \* The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defense of the prior patent, or compel him to incur the risk of its repeal. The present law thus adequately protects the interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies.”

The decision of the court below also seemingly questioned both the power and purpose of Congress to provide for a review by bill in equity of an administrative ruling made in the preliminary stage of an interference and thus imputes a Congressional intent not to affect the principles of equity jurisdiction.

A forcible statement of the principle applicable here was made in *United States v. Duell*, 172 U. S. 576, when Mr. Chief Justice Fuller said (p. 583):

“Since, under the Constitution, Congress has power ‘to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,’ and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that *Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object.*”

In that case it was held that the competency of Congress to provide for “judicial interference” with the action of the Patent Office cannot be successfully questioned as being an encroachment upon the judicial department. Hence, the view of the court below that assumption of jurisdiction in a case like the present one, is “contrary to the fundamental concept of equity jurisdiction” \* is in conflict with the holding in *United States v. Duell*, that:

“\* \* \* The nature of the thing to be done being judicial, Congress had power to provide for judicial interference through a special tribunal, *United States v. Coe*, 155 U. S. 76; and a *fortiori* existing courts of competent jurisdiction might be availed of.”

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\*Quoted from the opinion below in *Hoover v. Coe*.

**4. The decision below is contrary to the rule of construction adopted by this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168.**

In circumscribing the nature of the relief which a court in a Section 4915 action has the power to grant, the court below has placed itself squarely in conflict with the decision of this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168.

By way of preface to an explanation of that case, it should be mentioned that in *Atkins & Co. v. Moore*, 212 U. S. 285, 291, *American Steel Foundries v. Robertson*, 262 U. S. 209, and *Baldwin Co. v. Howard Co.*, 256 U. S. 35, 39, this Court held that the assimilation of the practice in respect of the registration of trade marks to that in securing patents as enjoined by Section 9 of the Trade Mark Act (33 Stat. 727, c. 592) made Section 4915, providing for a bill in equity to compel the Commissioner of Patents to issue a patent, applicable to a petition for the registration of a trade mark when rejected by the Commissioner.

The case presented in *Baldwin Co. v. Robertson* involved, however, not a bill under Section 4915 to review and correct the action of the Commissioner in refusing a trade mark registration, but instead, a bill under that section seeking an *injunction*, to prevent the Commissioner from cancelling certain trade marks which had already been registered by the plaintiff. *Thus the case was not one wherein the court was requested to adjudge that the plaintiff was entitled to receive a trade mark registration.*

Against jurisdiction to entertain such a bill it was expressly argued in that case that Section 4915 did not authorize the action (p. 169) and that to interpret Section 4915 as authorizing the action "requires a rewriting of Section 4915, and the incorporation into the section of both words and subject matter entirely foreign to its present plain language" (p. 171). Rejecting these contentions, Mr. Chief Justice Taft said (265 U. S. 179):

“The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a remedy by bill in equity as provided for a defeated applicant for a patent in Section 4915, Rev. Stats. We have in the cases cited given the closing words of Section 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. *It is not an undue expansion of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by Section 9 an appeal first lies to the Court of Appeals.* This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, *a right to resort to an independent bill in equity against the Commissioner to prevent cancellation.*”

*Baldwin Co. v. Robertson* clearly reveals that the purpose of Section 4915 is to afford a defeated applicant for patent an independent judicial review in every case where the Patent Office has made a final adverse decision. It demonstrates, moreover, the error into which the court below fell when it assumed that the only power under Section 4915 which a court has is that of making a decree authorizing and directing the Commissioner to issue a patent. If a court may enter an injunction in the exercise of its jurisdiction under Section 4915, then *a fortiori* it may make a decree “directing the Commissioner to find claims readable on plaintiff’s disclosure and allowable to him provided that later he is determined to have priority.” \*

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\*Quoted from the opinion below in *Hoover v. Coe*.

5. The decision below adopts a rule of statutory construction which nullifies the legislative purpose to provide alternative remedies to defeated applicants for patents and which is contrary to the interpretation of the same statute made by the Courts of the Second and Third Circuits.

By the Act of March 2, 1927 (Chap. 273, Sections 8, 11, 44, Stat. 1336), Section 4911 and 4915 were amended to provide that if an applicant for patent appealed to the Court of Appeals of the District of Columbia,\* he waived his right to proceed under Section 4915.

Thus Section 4911 provides that an applicant may have a direct appeal to the Court of Customs and Patent Appeals but that, in that case, "he waives his right to proceed under Section 63" (Section 4915) and Section 4915 provides that if an appeal is taken or is pending or is decided "no action may be brought under this section."

These amendments have been regarded as providing alternative remedies for an applicant who is dissatisfied with the decision of the Board of Appeals or the Board of Interference Examiners. Thus Rule 149 of the Patent Office provides:

"If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under Section 4915 R. S. (U.S.C. Title 35, Sec. 63).

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"From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under Section 4915 R. S.

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\*In 1929, the jurisdiction of the Court of Appeals, D. C., to entertain a direct appeal was transferred to the U. S. Court of Customs and Patent Appeals. Hence, the references in these sections to the Court of Appeals of the District of Columbia were changed to read "United States Court of Customs and Patent Appeals" (Act of March 2, 1929, c. 488, Section 2, 45 Stat. 1476).

instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The court below refused to recognize the 1927 amendments or to sanction the Patent Office rule. Indeed, it was held, in effect, that the petitioner's remedy in the instant circumstances resided solely in an appeal to the United States Court of Customs and Patent Appeals. If it be conceded that an appeal in the instant case lay to that court, then by the clear language of Sections 4911 and 4915, the remedy by bill in equity is also available. Those sections clearly provide alternative remedies for reviewing a refusal to issue a patent and have been so construed in cases arising in other circuits.

Thus in *Bakelite Corp. v. National Aniline & Chemical Co.* (C. C. A. 2), 83 F. (2d) 176, 177, the court said:

"It cannot be doubted that the statute, as it now reads, *means to give alternative remedies to an applicant to whom a patent has been refused*. He may appeal, 'in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. Section 59a); or he may have his remedy by bill in equity, 'unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section.' (35 U. S. C. A. Section 63)."

In *General Talking Pictures Corp. v. American Tri-Ergon Corporation, et al.* (C. C. A. 3), 96 F. (2d) 800, 812, the court referring to the 1927 Amendment said (p. 812):

"In our opinion the amendment has two practical results:

"First, it provides that the losing party in an interference is not entitled to his remedy by suit if an appeal to the United States Court of Customs and Patent Appeals is pending or has been decided."

The logic of the contention that if an applicant is refused a patent on the ground that the claims do not read upon his disclosure he has the right to appeal to the Court of Customs and Patent Appeals, then he also has the right to secure a review of the same type of refusal by way of a suit in equity under Section 4915, cannot be disputed. It is based upon the *alternative* and *optional* character of those remedies as provided by Congress. The force of a similar contention was recognized in *Baldwin Co. v. Robertson*, *supra*, when it was held that it was not an undue expansion of the statute to hold that a remedy in equity against the Commissioner was furnished "in every case in which by Section 9 an appeal first lies to the Court of Appeals."

The construction which has been imposed upon Sections 4911 and 4915 by the court below deprives an applicant whose claims, copied from an unexpired patent, have been refused, from availing himself of the right clearly expressed in Section 4915 to file a "bill in equity" instead of taking an appeal to the United States Court of Customs and Patent Appeals.

### Conclusion.

By reason of the principles which have already been discussed at length in *Hoover Co. v. Coe*, No. 486, both in the brief of the petitioner and of Paul A. Sturtevant, as *amicus curiae*, pursuant to which a writ of certiorari was granted therein on November 6, 1944, as well as for the reasons set out hereinabove, the present petition for writs of certiorari should be granted. ———

Respectfully submitted,

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December 7, 1944.

## APPENDIX.

## Statutes.

Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

“Section 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented, or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor \* \* \* if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, \* \* \* it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application. \* \* \*

“Section 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof,

he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. . . .”

“Section 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.”

Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353):

“Section 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner

of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by applicant, whether the final decision shall be in his favor or otherwise."

"Section 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint. . . ."

Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commisisoner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And

such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

"Section 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

. . . . .

Section 481. R. S. (U. S. C. title 35, section 6). The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Section 4886. R. S. (U. S. C., title 35, section 31). Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any dis-

inct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon proceeding had, obtain a patent therefor (The period is *two years* instead of "one year" where the application was filed prior to August 5, 1940. See Section 2 of Act of August 5, 1939, *infra*.)

*Act of August 5, 1939, 53 Stat. 1212:*

Section 2. This Act (amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes—U. S. C., title 35, sections 31, 62, 69, and 73—by changing "two years" to *one year*) shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Section 4904. R. S. (U. S. C., title 35; section 52). Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. (As to the interferences declared prior to October 5, 1939, see Section 5 of Act of August 5, 1939, *infra*.)

*Act of August 5, 1939, 53 Stat. 1212:*

Section 5. This Act (amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes—U. S. C., title 35, sections 52, 57, 59a, and 63—) shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Section 4911. R. S. (U. S. C., title 35, section 59a). If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes (U. S. C., title 35, section 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, section 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. (As to interference declared prior to October 5, 1939, see section 5 of Act of August 5, 1939, printed after R. S. section 4904, *ante*.)

Section 4915. R. S. (U. S. C., title 35, section 63). Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may

be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. (As to interferences declared prior to October 5, 1939 see Section 5 of Act of August 5, 1939, printed after R. S. Section 4904, *ante*.)

*Act of March 3, 1927, 44 Stat. 1394 (U. S. C., title 35, 72a):*

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the

same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (section 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

Section 4918. R. S. (U. S. C., title 35, section 66). Whenever there are interfering patents, any person interested in any of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented, but no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

#### RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

Rule 63 (d). Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set

for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

Applications will not be advanced for examination excepting upon order of the Commissioner either to expedite the business of the office or upon a verified showing which in the opinion of the Commissioner will justify so advancing it.

Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same

invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents, contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy, in this country, before the filing date of the patentee; and, when required, the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

Rule 95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

Rule 96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

Rule 149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Pat-

ent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, That if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If any applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, section 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). See rule 153 (a).

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

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# In the Supreme Court of the United States

OCTOBER TERM, 1944

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No. 738

MINNESOTA MINING & MANUFACTURING COMPANY,  
PETITIONER

*v.*

CONWAY P. COE, COMMISSIONER OF PATENTS

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF  
COLUMBIA

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BRIEF FOR THE RESPONDENT IN OPPOSITION

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## OPINION BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 417-419) is reported in 145 F. (2d) 25.

## JURISDICTION

The judgments of the District Court were entered on December 1, 1942 (R. 16, 159). Motions to open the judgment and reconsider the cause,

and motions for additional and corrected findings were denied on January 4, 1943 (R. 16-24, 159-165). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 420). A petition for rehearing was denied on September 8, 1944 (R. 426). The petition for a writ of certiorari was filed on December 8, 1944. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTION PRESENTED

In our view, no question is properly presented here since the petition and supporting brief take no issue with any ruling of the District Court or the Court of Appeals but seek to challenge a ruling which neither court made.

#### STATUTE AND REGULATION INVOLVED

The relevant portions of the statute and regulation involved are set forth in the Appendix, pp. 11-12, *infra*.

#### STATEMENT

On December 1, 1933, petitioner's assignor, C. L. Jewett, filed an Original Application in the United States Patent Office, presenting 59 claims covering improvements in colored granulated material particularly suitable for roofing purposes (R. 22, 34-35, 225-245). Following final rejection by the Patent Office of 33 of the claims for

want of invention<sup>1</sup> (R. 257-262), petitioner instituted suit in the United States District Court for the District of Columbia under Section 4915 of the Revised Statutes (35 U. S. C. 63), and secured a decree on July 13, 1939, adjudging that 15 of the rejected claims were patentable (R. 262-263; 28 F. Supp. 80).<sup>2</sup> The Commissioner of Patents then issued a Notice of Allowance of the 15 claims (R. 264-265). Petitioner's assignor thereupon filed two additional applications in the Patent Office: a "Renewal Application" on December 1, 1939, containing the 15 allowed claims and five additional claims,<sup>3</sup> and a "Continuation-in-Part Application" on November 20, 1939, presenting 13 additional claims.<sup>4</sup>

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<sup>1</sup> Some of the rejected claims were also disallowed for want of support in the applicant's disclosure (R. 256-257, 259, 262). Five additional claims were held unsuitable for inclusion in the same application with the other claims (R. 247, 258). The disposition of the remaining claims in the application (apparently increased by amendment to a total of 70, R. 225-245, 247) is not disclosed by the record.

<sup>2</sup> The remaining 18 appealed claims had been withdrawn by petitioner at the trial (R. 263).

<sup>3</sup> "A renewal application is one that, having been allowed and forfeited, is restored to the Office docket by the payment of a new filing fee". Wolcott, *Manual of Patent Office Procedure* (7th ed. 1936), p. 200.

<sup>4</sup> A "Continuation-in-Part Application" is "an application filed during the lifetime of an earlier application by the same applicant, repeating some portion or all of the earlier application, and adding matter not found in the said earlier case". Wolcott, *id.* at p. 199.

The Continuation-in-Part Application (R. 286-311) included two claims which had been copied from an issued patent (claims 8 and 9 of Veazey patent No. 2,142,540) (R. 9, 12). These were rejected in the Patent Office on the ground that they were not supported by the disclosure of the Original Application and had been refused in the R. S. 4915 suit, and that considered apart from the Original Application the claims were "fully met" by the Veazey patent (R. 312-313, 369-372). The remaining 11 claims were also rejected.<sup>5</sup>

The Renewal Application sought renewal of the Original Application with an amendment containing claims not theretofore allowed (R. 265-266). As then amended, the Renewal Application included the 15 claims already held patentable in the R. S. 4915 suit and five new claims, four of which were copied from outstanding patents.<sup>6</sup> After

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<sup>5</sup> For one or more of the following reasons: "vague and indefinite"; defining "the product by the method of making the same"; being "fully" or "substantially met" in outstanding patents (R. 312-315, 369-377). Two of these claims, by which applicant sought to provoke an interference with the Veazey patent, were held unsuitable for that purpose, because more specific than the Veazey claims (R. 377). Four additional claims tendered upon a request for reconsideration were also refused (R. 365).

<sup>6</sup> The four copied claims were taken from: claims 8 and 9 of Veazey patent No. 2,142,540 and claims 13 and 18 of Hillers patent No. 2,070,359 (R. 265-266, 22-30, 35, 263, 157).

rejecting three of the five new claims,<sup>7</sup> the primary examiner ruled that the remaining two new claims (those copied from Hillers) related to a different species of the alleged invention than the 15 claims previously held patentable; that no claim generic to the two different species was allowable; and that therefore an "election of a single species for further prosecution" was required (R. 268).<sup>8</sup> Petitioner then elected to prosecute, not the 15 claims previously adjudged patentable, but the

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<sup>7</sup> The two claims copied from Veazey were rejected "as containing matter not disclosed in the original specification and as unduly broad in view of the original disclosure". The single new uncopied claim was rejected "as fully met" by other outstanding patents, and "as containing new matter" (R. 267-268).

<sup>8</sup> The 15 allowed claims were said to be "directed to an unfused reaction product of clay and sodium silicate" whereas the two claims copied from Hillers were "directed to a fusion product of cryolite, liquid adhesive and coloring agent" (R. 268).

Rule 41 of the Rules of Practice in the Patent Office provides in part that "two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided*, That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species." The rule further provides that where an application contains one or more generic claims, and claims to more than one species thereunder, and the primary examiner rules that no generic claim presented is allowable, the applicant is required "to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable". See Appendix, *infra*, p. 12.

two claims copied from Hillers. In view of such election, the primary examiner rejected 21 claims (including the 15 claims previously held patentable and other claims added by later amendment (R. 29, 273)) as directed to a non-elected species, thus requiring petitioner to file one or more divisional applications for those claims if it still desired to pursue them.<sup>9</sup> The remaining claims were rejected on other grounds.<sup>10</sup> (R. 269-270.)

Following affirmance by the Board of Appeals of the decisions on the Renewal Application and the Continuation-in-Part Application (R. 273-285, 377-382), petitioner instituted two separate suits against the Commissioner of Patents under R. S. 4915 in the United States District Court for the District of Columbia, praying, in each case, for a decree that petitioner was entitled to a patent for the rejected claims and directing the Commissioner to allow those claims (R. 9, 33). Both cases were consolidated for trial (R. 37), and after receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 37-154), the District Court

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<sup>9</sup> The rejection of a non-elected species of claims under Rule 41 merely means that those claims cannot be prosecuted in the same application with the elected species of claims. It is not a ruling on the patentability of the rejected claims.

<sup>10</sup> While the precise number of claims so rejected does not appear from the record, the grounds for their rejection included: non-elected species; unpatentable over outstanding patents; and rejection of similar claims by the Board of Appeals when considering the Continuation-in-Part Application (R. 269-270).

entered findings of fact and conclusions of law (R. 13-16, 155-158), and on December 1, 1942 ordered that the complaint in each case be dismissed (R. 16, 159). In the action covering the claims involved in the Continuation-in-Part Application, the District Court held that all the claims urged were "unpatentable in view of the prior art," and that the two claims copied from Veazey were anticipated by outstanding patents and were not supported by the disclosure of the Original Application (R. 13-15).<sup>11</sup> In the action based on the Renewal Application, the District Court held that petitioner was not entitled to a patent for any of the claims in suit, concluding that 21 of them (including the 15 held patentable in the first suit under R. S. 4915) were properly rejected as drawn to non-elected species (R. 155-158).<sup>12</sup> On appeal, the United States Court of

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<sup>11</sup> Certain of the claims were also rejected for one or more of the following grounds: want of support in the disclosure; anticipation in outstanding patents; being wholly dependent upon process steps; failure to show that the invention was completed by the applicant in any form at any time prior to the filing date of the Continuation-in-Part application or that the applicant exercised reasonable diligence in attempting to reduce such invention to practice at any time prior to that time (R. 15).

<sup>12</sup> The remaining claims (other than those abandoned at the trial) were held unpatentable on one or more of the following grounds: lack of support in the disclosure; unpatentable over outstanding patents; and being "alternative" (R. 157-158).

Appeals for the District of Columbia affirmed both judgments (R. 420).

#### ARGUMENT

The petition for certiorari and brief in support thereof do not specify as error nor argue any of the multiple grounds upon which the Patent Office and the two courts below denied all of petitioner's claims. The petition and brief are devoted entirely to the assertion that the court below affirmed the dismissal of the complaints for want of jurisdiction, as in *Hoover Co. v. Coc*, 144 F. (2d) 514 (App. D. C.), certiorari granted November 6, 1944 (No. 486, this Term), and they argue that this was error.

This utterly misrepresents the decisions below, for the opinion of the court clearly shows that the judgments of the District Court were affirmed on the merits, and were not dismissed for want of jurisdiction. The court below viewed the rejected claims in both cases as seeking in substance "to enlarge the scope of a patent on a single discovery beyond what was allowed by the former decision of the District Court" (R. 418). Observing that "The situation is the familiar one where an applicant seeks a patent right on a general formula and in addition a patent right on each ingredient in the formula," the court below concluded (R. 418-419) that "Here we have no information as to the effect on the building trades of giving the

plaintiff separate patent rights on the use of particular ingredients in addition to its general patent right on the use of all of them together," and therefore affirmed the judgments below, citing *Monsanto Chemical Co. v. Coe*, 145 F. (2d) 18 (App. D. C.).<sup>13</sup> Indeed, far from disclaiming jurisdiction under the rule enunciated in the *Hoover* case, the court below expressly stated (R. 418):

A few of the claims are copied from other applications which were filed later than the original application in this case. It is not clear that the doctrine of *Hoover Co. v. Coe* (No. 8602, decided this day), applies to these claims because it may be that if they were held to be patentable the record contains enough evidence to show that the plaintiff was prior in time without the necessity of further interference proceedings. It is unnecessary to decide this question because the appeal involves a number of similar claims which were not copied.

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<sup>13</sup> In the *Monsanto* case, the court below held that in reviewing a determination by the Patent Office rejecting some claims but allowing other claims in an application, the dissatisfied applicant has the burden of proving by "expert evidence, at least some portion of which should be from disinterested witnesses" that the allowance of the rejected claims in addition to the claims already allowed, would not give such control over the particular industry involved as to impede the progress of the art. 145 F. (2d) at 24.

Accordingly, it is completely erroneous to suggest that the court below relied upon the *Hoover* case or dismissed the appeals for want of jurisdiction.<sup>14</sup>

CONCLUSION

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,  
*Solicitor General.*

FRANCIS M. SHEA,  
*Assistant Attorney General.*

DAVID L. KREEGER,  
*Special Assistant to the Attorney General.*

JOSEPH B. GOLDMAN,  
*Attorney.*

JANUARY 1945.

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<sup>14</sup> Answering the petitioner's contention that the claims held to be too broad in scope in the Patent Office had nevertheless been allowed to Veazey, the court below held that the situation would not be improved "by a second mistake" allowing the same claims to petitioner (R. 424).





## APPENDIX

Section 4915 R. S., as amended (35 U. S. C. 63) provides as follows:

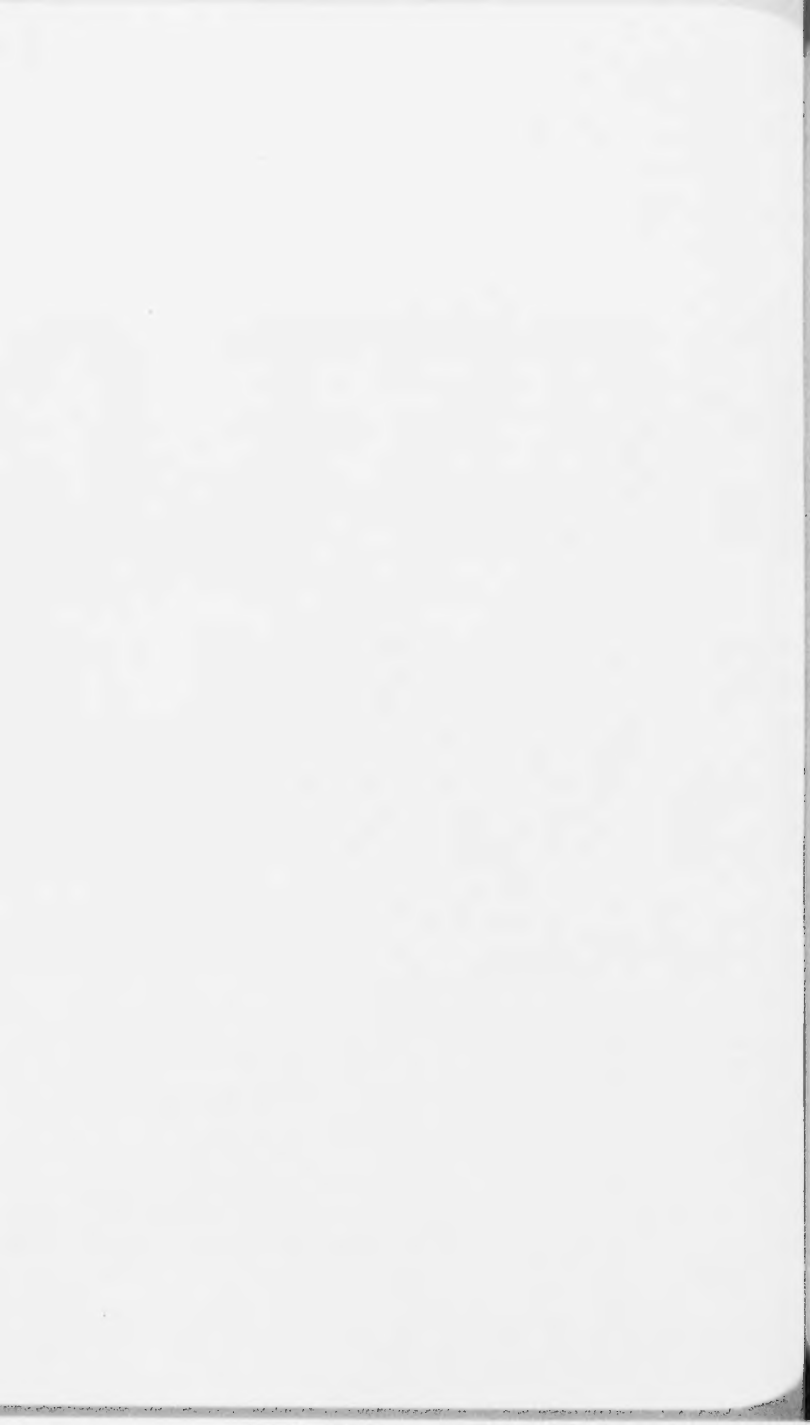
SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties

the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Rule 41 of the Rules of Practice in the United States Patent Office provides:

41. Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided*, That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species. In the first action on an application containing a generic claim or claims and claims to more than one species thereunder the examiner, if he is of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable.





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MAR 9 1945

CHARLES CLARE DROPLEY  
CLERK

IN THE  
**SUPREME COURT OF THE UNITED STATES**  
OCTOBER TERM, 1944.

MINNESOTA MINING & MANUFACTURING  
COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF  
PATENTS

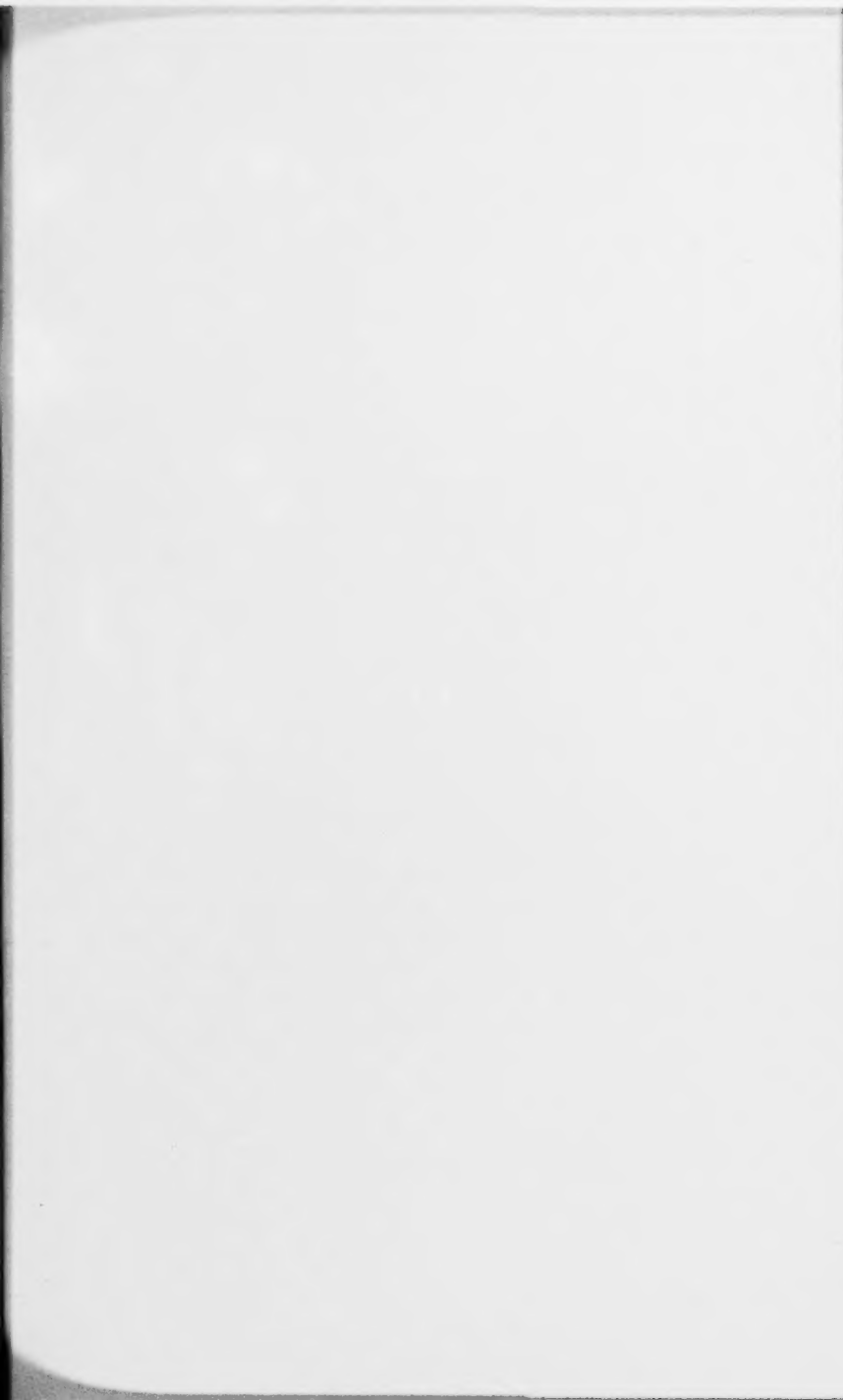
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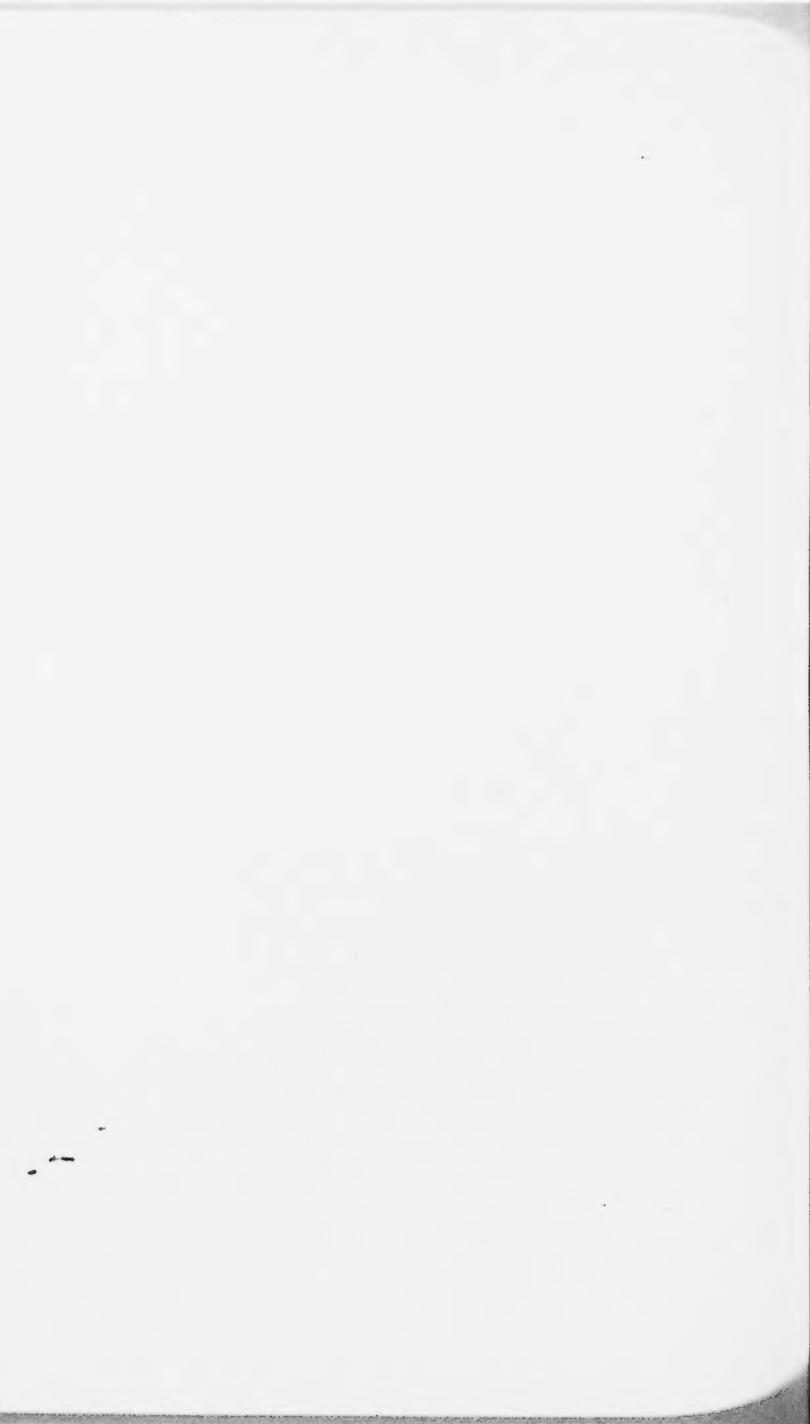
ON PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA

PETITION FOR REHEARING.

J. BERNHARD THIESS,  
SIDNEY NEUMAN,  
HAROLD J. KINNEY,  
*Counsel for Petitioner.*







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PATENTS

No. 738

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**PETITION FOR REHEARING.**

*To the Honorable Harlan Fiske Stone, Chief Justice of the  
United States, and the Associate Justices of the Supreme  
Court of the United States:*

The above named petitioner presents this, its petition for rehearing and for reconsideration of the order denying the instant petition, in the belief that there are present in this case compelling reasons which justify the grant of the writ.

The reasons which petitioner failed to make clear are these:

The decision of the Court below, written by Associate Justice Thurman Arnold, by which the action of the Patent Office in refusing certain patent claims to petitioner was affirmed, vitally affects the absolute property rights of all inventors in that it holds that they may not henceforth solicit patents and conduct their economic affairs within the scope of the present patent statutes, but rather re-

quires that they submit to and comply with certain wholly novel standards and tests adopted by the Court as prerequisites to the grant of patents. These tests and standards, bottomed on considerations of the monopoly and industrial control problems of our economy, rather than on the provisions of the statutes, are set forth elaborately in Judge Arnold's opinion in *Monsanto Chemical Co. v. Coe* (App. D. C.), 145 F. (2d) 18, cited by him as the controlling authority for the ruling made in the case at bar (Rec. 419; 145 F. (2d) 25).

The instant attempt by Judge Arnold to write doctrinaire reforms into the patent statutes on the ground that their present provisions are unwise and are being administered, both by the Patent Office and the courts, prejudicially to the interests of the public, presents, in our submission, an urgent need for this Court to exercise its supervisory power of review. Substantially all of the actions brought under § 4915 R. S. (35 U. S. C. § 63)<sup>1</sup> by applicants to whom patents have been refused in *ex parte* cases by the Patent Office are commenced in the United States District Court for the District of Columbia and the decisions of the Court below are controlling in the adjudication and disposition of those actions. Moreover, that Court's decisions are intended for the guidance of the Patent Office in its administration of the patent statutes. Hence, if erroneous, the rule adopted in the instant case, will produce unfortunate consequences in practice.

As a further ground of rehearing, we observe that the recent decision of this Court in *Hartford-Empire Co. v. United States*, .... U. S. ...., 89 L. Ed. Ad. Op. 302, decided on January 8, 1945, subsequent to the filing of the petition for certiorari herein, has clearly revealed the untenable basis of the decision of the Court below. In that

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<sup>1</sup> Appendix, post p. 14.

case, this Court, contrary to a mistaken view of trend taken by the Court below, reaffirmed the long settled doctrine that "a patent is property, protected against appropriation both by individuals and government." Whereas, as we presently show, the Court below held that vital public interests demand that patent rights be granted only when the Courts are fully apprised of the industrial control which a patent probably will give, Mr. Justice Roberts, writing the opinion for this Court in the *Hartford* case, said that a patent owner is "not in the position of a quasi-trustee for the public or under any obligation to see that the public acquires the free right to use the invention" or under any obligation "either to use it or grant its use to others." And where the Court below has ruled that patent claims will not be awarded in the absence of "information as to the effect<sup>2</sup> on the building trades of giving the plaintiff separate patent rights on the use of particular ingredients" this Court has held in the *Hartford* case that if an inventor "discloses the invention in his application so that it will come into the public domain at the end of the 17 year period of exclusive right he has fulfilled the only obligation imposed by the statute."

The Court below adopted its industrial control standard because (a) it considers the long standing judicially sanctioned practice which permits multiple claims in a patent to be responsible for a confusion of the issues of invention and scope,<sup>3</sup> (b) it regards patents for chemical pro-

<sup>2</sup> From *Monsanto Chemical Co. v. Coe*, it will appear that this is a requirement that the patent applicant supply evidence by disinterested witnesses, *preferably his competitors*, as to the degree of control which he reasonably expects, and which the competitors reasonably fear, from the grant of the claims requested.

<sup>3</sup> The rule is that each claim embodies a complete invention and is in effect an independent patent for the device it covers. See *Leeds & Catlin v. Victor Talking Mach. Co.*, 213 U. S. 301, 319, and *Vencer Mach. Co. v. Grand Rapids Chair Co.*, (C. C. A. 6) 227 Fed. 419, 425.

cesses and those based on scientific principles to be inimical to our economy since they are concerned with ways of doing things rather than with the machines which do them,<sup>4</sup> and (c) it regards our complex modern technology to be of such character that patents should no longer be granted without expert evidence from men who know the industrial field. In short, a standard of "patent scope" *measured only in the light of probable industrial control* has been adjudged by the Court below to be a substitute for the present statutory requirements of invention, novelty and utility (145 F. (2d) 18).

Thus, it appears in the instant case that the Court below, without actually considering the claims which had been refused to petitioner by the Patent Office, treated all of them as mere "permutations and combinations" in the general formula covered in allowed claims and held that petitioner was not entitled to a patent for all of the claims because there was here "no information as to the effect on the building trades" of giving the petitioner "separate patent rights," citing, as the basis of this ruling, the decision in *Monsanto Chemical Co. v. Coe*. Realizing that two claims sought by petitioner had been copied from an issued

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<sup>4</sup> Ever since *Cochrane v. Deener*, 94 U. S. 780 and *Tilghman v. Proctor*, 102 U. S. 707, processes have been held to be as much entitled to the protection of the law as a machine or manufacture. The essence or gist of a process is its principle and mode of treatment, this being an act or series of acts performed either chemically or physically upon the subject matter to be transformed and reduced to a different state or thing. This Court has unequivocally ruled that a process is patentable "irrespective of the \* \* \* instrumentalities used" (94 U. S. 787) and that "The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process if he is really its inventor or discoverer" (102 U. S. 728).

Any construction of the patent laws which protects the inventor in no more than the tools or appliances used in his process is a clear annulment of the law. It ignores the distinction between a process and a machine and in effect refuses the full protection of the patent laws to the inventor of a new and useful process.

patent to one Veazey and therefore are already at large in the affected industry, the Court attempted to bridge the inconsistency apparent on the face of its opinion by purporting to consider these claims specifically. In seeming discharge of its judicial function, the Court held that these claims could not be had by petitioner because it "appears" that the Patent Office *might* have made a mistake in granting them to Veazey. If this was so, said the Court, the situation is not improved "by a second mistake of allowing the same claim" to petitioner. Neither the trial Court nor the Court below has expressly found that the Patent Office did actually make a mistake in originally granting the Veazey claims. If in fact the Veazey claims are valid and patentable, as construed by petitioner, then petitioner has been deprived of an absolute property right and has been denied its substantive rights, under §§ 4904 and 4918 (35 U. S. C. §§ 52, 66)<sup>5</sup>, to contest the issue of priority with Veazey.

The only question presented on appeal in the Court below as to the Veazey claims was the legal question of whether or not there is support for them in petitioner's application. This is the same legal question presented to this Court by Question 4 of the petition for certiorari. Petitioner hereby waives consideration by the Court of all of the requested claims, save its claims 71, 72, 92 and 93 (Rec. pp. 25, 27) which are respectively claims 8 and 9 of the Veazey Patent and two article claims based thereon.<sup>6</sup>

<sup>5</sup> Appendix, post pp. 14, 15.

<sup>6</sup> The Veazey patent claims are *prima facie* valid and patentable and the burden of challenging them is a heavy one. *Radio Corp. v. Radio Eng. Laboratories*, 293 U. S. 1; *Mumm v. Decker*, 301 U. S. 168. Furthermore, the authority which granted them is estopped to attack their validity. *United States v. American Bell Telephone Co.*, 167 U. S. 224; *United States v. United States Gypsum Co.*, 53 F. Supp. 889. If the instant petition for certiorari is granted, the only question which this Court need decide is the legal one of whether or not petitioner's application will support these claims.

**THE MONSANTO RULE WHICH WAS INVOKED AGAINST PETITIONER IS ENTIRELY WITHOUT STATUTORY WARRANT AND IS IN CONFLICT WITH APPLICABLE DECISIONS OF THIS COURT.**

The rule of the *Monsanto* case which was applied by the Court below is a wholly novel one and constitutes a major departure from a patent policy and practice of long standing. There is no warrant or authority for the rule under any fair and reasonable construction of the present patent statutes. Indeed, although Judge Arnold disclaimed any assertion of a "new principle," his decision is clearly a *judicial* rather than *legislative* reformation of the patent statutes, based on considerations of economics and monopoly problems, whereby questions of the "scope" of patents are required to be "treated in the light of industrial facts." According to this unprecedented doctrinaire dogma, questions of patentability such as whether a patent should be granted "on mere novelty" or restricted to a "veritable flash of genius" become *academic* and the "real problem" is that of preventing "patents from becoming a monopoly on technical progress in defiance of the Constitution." Under the *Monsanto* rule, the *sole* question to be determined by the Patent Office and the Courts, as a prerequisite to the grant of a patent, is the "amount of control that should be allowed to the inventor as his reward."<sup>7</sup>

In formulating the *Monsanto* rule, the Court below held that vital public interest demands that the broad discre-

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<sup>7</sup> Patentability is presently required by this Court (*Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91) to depend not only on novelty but also on invention revealed in the form of a "flash of creative genius, not merely the skill of the calling." The *Monsanto* rule as to scope, however, disregards this requirement and would permit gadget patents "of little scope" to issue on the ground that they are "safe enough." Even "bright idea patents *short of genius*" may be safely awarded, provided that they are limited in scope as required by their probable impact upon industry.

tionary judgment vested in the Patent Office by the present patent statutes be exercised *only* when evidence is presented "on the industrial control which the patent probably will give." Thus it was held that the Courts, and of course, the Patent Office, which first acquires jurisdiction over an application, must examine the actual degree of control which the inventor hopes to gain by means of all his claims taken as a whole "over competing industry and competing invention." By a palpably arbitrary fiat, it was also ruled that the best evidence with which to meet the inquiry satisfactorily is that of "disinterested experts or competitors who are aware of the monopoly problems in the field of the patent." Although, under the present system, the Patent Office represents the public and its interests, the rule adopted by the Court below requires, in effect, that an applicant must supply evidence from his competitors that they will not be affected by the scope of the solicited claims. The mere statement of the rule reveals its absurdity, and yet, the Court below held that without such evidence a patent application record was similar to a "case in which the testimony of an interested adverse party has been excluded."

As every one well knows, the patent application of an inventor is a carefully guarded secret until the patent issues. This is a protection made available by the present patent statutes, but under the *Monsanto* rule this statutory privilege of secrecy is to be violated, and an applicant is to be required to disclose his pending application to his competitors in order to secure their *required* testimony as to the probable industrial control which will result from the issuance of the patent.

If a claim is to be regarded as too broad solely on considerations of the probable industrial control which might be exercised, then the rights of inventors are being made subject to modifications and qualifications dictated by the economic interests of competitors; they are being made to

conform to an economic and social program not provided for by the patent statutes and the inventor is being required to conduct his affairs and compete with others on a level insisted upon by these others.

This procedure violates the letter and spirit of our present patent laws. *The exclusion of competitors* from the use of a new improvement is the *very essence* of the right conferred by patent. If an inventor, following the patent statutes, proceeds to disclose his invention to the public, he is entitled to "insist upon all the advantages and benefits which the statute promises to him" (*Paper Bag Patent Case*, 210 U. S. 409, 424).\*

The patent law may be searched in vain for any provision that a patent claim may be withheld when the applicant is claiming no more than that which he invented or discovered.

The only prerequisite, prescribed by the patent statutes, to the grant of an exclusive patent privilege is that the improvement shall possess invention, novelty and utility, that is to say that it shall not have been "known or used by others in this country \* \* \* not patented or described in any printed publication \* \* \* and not in public use"

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\* The Constitution declares that "Congress shall have the power to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Art. I, § 8, cl. 8. The *exclusive* patent right which Congress has authorized under this constitutional power is *property*. The essence of this constitutional property right is the privilege of the patent owner to use, or not to use, his invention, without question of motive (*Paper Bag Patent Case*, 210 U. S. 409, 429) and the right to *exclude* every one from its unpermitted use for the time prescribed in the statute (*Bloomer v. McQuewan*, 14 How. 539, 549). The public faith is forever pledged for this exclusive enjoyment (*Grant v. Raymond*, 6 Pet. 218, 243) as the consideration for the invention coming into the public domain upon expiration of the patent.

(35 U. S. C. § 31).<sup>9</sup> The scope of the exclusive privilege is that determined by the extent of the invention, as accurately measured by the state of the prior art and knowledge (*Garneau v. Dozier*, 102 U. S. 230, 234; *Eibel Co. v. Minnesota etc. Co.*, 261 U. S. 45, 63).

The present laws (35 U. S. C. 33)<sup>10</sup> require an inventor, as a condition precedent to obtaining a patent, to deliver to the Commissioner of Patents a written description of his invention or discovery and "of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same." This is the obligation imposed for the benefit of the public so that the invention as patented may come into the public domain at the end of the period of exclusive right.

The statute (35 U. S. C. § 33) also requires that the applicant for patent "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." The claims of a patent have consequently been held to be creatures of statute, in which the inventor is required to define precisely what his invention is (*White v. Dunbar*, 119 U. S. 47, 51). The prevailing rules by which the scope of claims is governed are those announced by this Court in the *Motion Pictures Patent Case*, 243 U. S. 502, and *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228. Thus, a claim is the measure of the patented invention, *e.g.*, its metes and bounds, and need only "clearly distinguish what is claimed from what went before in the art."

The present patent statutes (35 U. S. C. § 36)<sup>11</sup> require

<sup>9</sup> Appendix, post p. 13.

<sup>10</sup> Appendix, post p. 13.

<sup>11</sup> Appendix, post p. 14.

the Commissioner of Patents, on the filing of an application for patent, to "cause an examination to be made of the alleged new invention or discovery." If on such examination it shall appear to the Commissioner "that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent."

There is thus nothing in the present statutes, either in the form of obligations imposed upon applicants or in the form of authority vested in the Commissioner of Patents, which requires the former to supply, or the latter to require, evidence in the light of the industrial facts as to the probable control which the inventor may reasonably expect, or his competitors may reasonably fear, from the grant of the requested claims.

If the Commissioner of Patents believes that the claims are not patentable and rejects them, then the applicant may have the patentability of the claims reconsidered by the Courts by means of an action under § 4915, R. S. (35 U. S. C. § 63). Neither the District Court nor the Court of Appeals in such an action should be permitted to avoid, under the present patent statutes, a consideration of the patentable novelty of the requested claims on the grounds set forth in the *Monsanto* case, that an applicant must first supply evidence of the effect or impact upon industry which the scope of the claims requested by him will probably have. Therefore, since this novel test does not find expression in the statutes, this Court should not give it continuing vitality as a standard by which the issuance of patents is to be determined. The *Monsanto* rule invoked by the Court below against petitioner is also in direct conflict with the governing rule of law recently reaffirmed by this Court in the *Hartford* case when it quoted the follow-

ing from *Chapman v. Wintroath*, 252 U. S. 126, 137 and *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247:

"A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. **No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.**"<sup>12</sup>

There can be no question of the *exclusive* power of Congress to define the nature of the patent privilege now available under the existing patent statutes. Congress, exercising its plenary control over patents, has not thus far seen fit to adopt the social reforms promulgated by the Court below. With the wisdom of that action the Court below should have had no concern.

As was said by Mr. Justice Black in *United States Ex Rel. Marcus et al. v. Hess et al.*, 317 U. S. 537:

"The government presses upon us strong arguments of policy against the statutory plan, but the entire force of these considerations is directed solely at what the government thinks Congress should have done rather than at what it did. It is said that effective law enforcement requires that control of litigation be left to the Attorney General; \* \* \* and finally that conditions have changed since the Act was passed in 1863. **But the trouble with these arguments is that they are addressed to the wrong forum. Conditions may have changed, but the statute has not.**"

<sup>12</sup> Emphasis in quotations has been added.

For the reasons stated, it is respectfully urged that this petition for a rehearing be granted and that, upon further consideration, the order of this Court denying the petition for a writ of certiorari be vacated and the said petition be granted.

Respectfully submitted,

J. BERNHARD THIESS,

SIDNEY NEUMAN,

HAROLD J. KINNEY,

*Counsel for Petitioner.*

**Certificate of Counsel.**

The undersigned counsel for petitioner hereby certifies that the foregoing petition for rehearing is presented in good faith and not for delay.

J. BERNHARD THIESS.





**APPENDIX.****STATUTES INVOLVED.**

§ 4886 R. S. (35 U. S. C. § 31):

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor R. S. § 4886; March 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.”

§ 4888 R. S. (35 U. S. C. § 33):

“Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly

point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible. R. S. § 4888; March 3, 1915, c. 94, § 1, 38 Stat. 958; May 23, 1930, c. 312, § 2, 46 Stat. 376."

§ 4893, R. S. (35 U. S. C. § 36):

"On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. R. S. § 4893  
\* \* \* Act July 8, 1870, c. 230, § 31, 16 Stat. 202."

§ 4904 R. S. (35 U. S. C. § 52):

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. R. S. § 4904; March 2, 1927, c. 273, § 4, 44 Stat. 1336; Aug. 5, 1939, c. 451, § 1, 53 Stat. 1212."

§ 4915 R. S. (35 U. S. C. § 63):

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and

Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 4888, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212."

§ 4918 R. S. (35 U. S. C. § 66):

"Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the

owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both of the patents void in whole or in part, upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. R. S. § 4918, March 2, 1927, c. 273, § 12, 44 Stat. 1337."





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No. 738

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*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.*

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**MOTION FOR LEAVE TO FILE SECOND  
PETITION FOR REHEARING.**

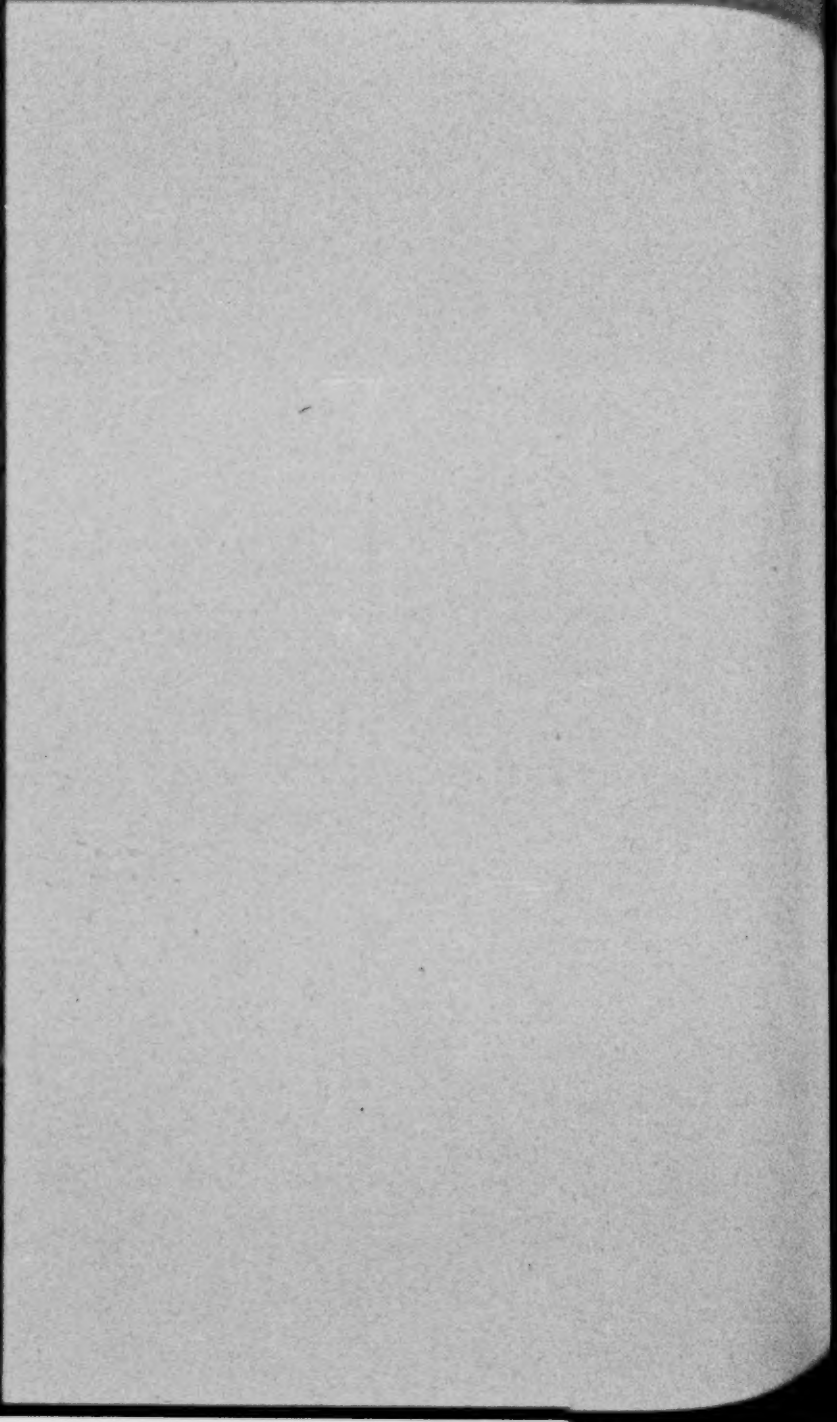
and

**SECOND PETITION FOR REHEARING.**

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**J. BERNHARD THIES,**  
**SIDNEY NEUMAN,**  
**HAROLD J. KINNEY,**

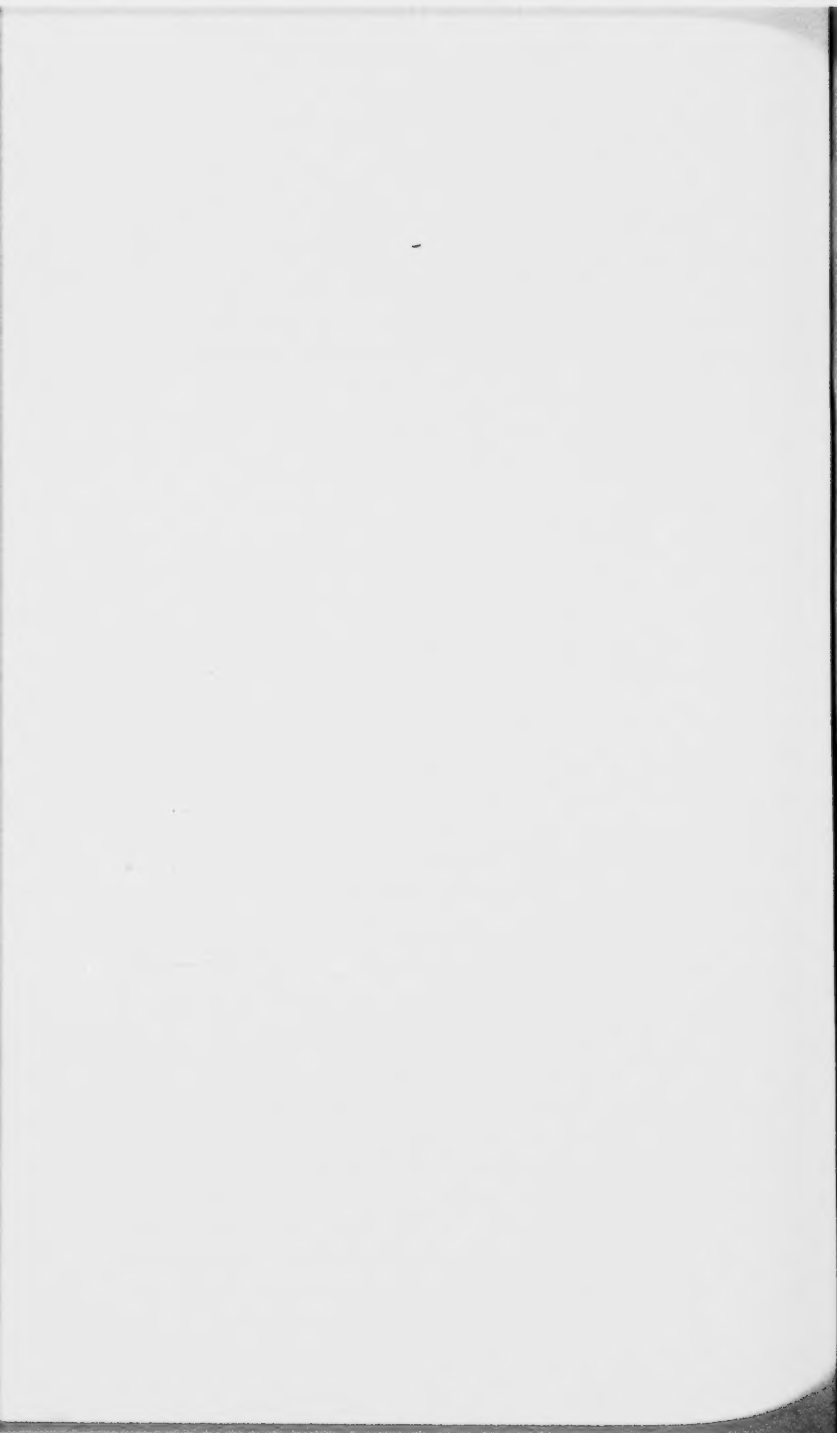
*Counsel for Petitioner.*



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IN THE  
SUPREME COURT OF THE UNITED STATES  
OCTOBER TERM, 1944.

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MINNESOTA MINING & MANUFACTURING  
COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF  
PATENTS

No. 738

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**MOTION FOR LEAVE TO FILE SECOND  
PETITION FOR REHEARING.**

*May it Please the Court:*

Now comes the petitioner, Minnesota Mining & Manufacturing Company, by its counsel, and respectfully moves this Honorable Court for leave to file the annexed "Second Petition for Rehearing."

In support of this motion petitioner shows:

(1) In opposing the granting of the writ of certiorari in this case, respondent asserted (Brief for the Respondent in Opposition, p. 2) that "no question is properly presented here," and that petitioner had taken "no issue with any ruling of the District Court or the Court of Appeals."

(2) The foregoing assertion had no application whatsoever to question No. 4 set forth at page 4 of the petition for a writ of certiorari. Respondent did not even discuss that question. It is the only question now relied upon by petitioner and is the only one discussed in the

petition for rehearing which was denied on March 12, 1945.<sup>1</sup>

(3) It has been admitted by the respondent (Brief for the Respondent in Opposition, pp. 8-9) that the Court below affirmed the judgments of the District Court because there was here "no information as to the effect on the building trades of giving the plaintiff separate patent rights," citing *Monsanto Chemical Co. v. Coe* (App. D. C.), 145 F. (2d) 18. Respondent has also admitted that, under the *Monsanto* rule, an "applicant has the burden of proving \* \* \* that the allowance of the rejected claims \* \* \* would not give such control over the particular industry involved as to impede the progress of the art."

(4) There is thus admittedly presented in this case this important question of law which should be settled by this Court:

Is it a prerequisite to the grant of patents under the provisions of the present patent statutes that the applicant for patent must furnish either to the Patent Office or to the Federal courts having jurisdiction under Section 4915 R. S. (35 U. S. C., Sec. 63) evidence as to the industrial control and effect upon industry which the claims applied for will probably have?

(5) The case at bar presents a question which is a variant, *i. e.*, another major aspect, of the fundamental question now before this Court in *Special Equipment Co. v. Coe*, No. 469 of this term, which was argued on March 2, 5, 1945.

(6) The second petition for rehearing, annexed hereto, is meritorious and, together with the first petition for rehearing, adequately presents a question of great public importance, as well as an important question of patent law which ought to be settled by this Court.

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<sup>1</sup> Questions 1, 2, and 3 of the petition for a writ of certiorari were dropped by petitioner in its petition for rehearing (p. 5).

(7) A case which is believed to authorize the filing of a second petition for rehearing and to sustain the jurisdiction of this Court to grant its writ of certiorari on the basis of such petition, is *Cleveland Trust Company v. Scriber-Schroth Company*, 304 U. S. 587, *Id.* 305 U. S. 47.

WHEREFORE it is prayed that leave be granted petitioner to file its second petition for rehearing annexed hereto.

J. BERNHARD THIESS,  
SIDNEY NEUMAN,  
HAROLD J. KINNEY,  
*Counsel for Petitioner.*

The undersigned counsel for petitioner hereby certifies that the foregoing "Motion for Leave to File Second Petition for Rehearing" is believed to be well founded in law and in fact, and that it is not interposed for the purpose of delay.

J. BERNHARD THEISS.

IN THE  
SUPREME COURT OF THE UNITED STATES  
OCTOBER TERM, 1944.

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<b>MINNESOTA MINING &amp; MANUFACTURING COMPANY,</b>	}	No. 738
Petitioner,		
vs.		
<b>CONWAY P. COE, COMMISSIONER OF PATENTS</b>	}	

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**SECOND PETITION FOR REHEARING.**

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*To the Honorable Harlan Fiske Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:*

The above named petitioner presents this its second petition for rehearing, and in support hereof shows:

1. The original petition for a writ of certiorari was filed in this Court on December 8, 1944.
2. By order of this Court entered on January 15, 1945, the prayer of the said petition was denied.
3. After enlargements of the time therefor were duly obtained, a petition for rehearing was filed in this Court on March 9, 1945.
4. By order of this Court entered on March 12, 1945, the said petition for rehearing was denied.
5. Every reason which was advanced by the petitioners

in *Special Equipment Company v. Coe*<sup>1</sup> and *Hoover Company v. Coe*<sup>2</sup> for the granting of the writs in those cases also exists in this case. If the nature of the questions presented in those cases moved this Court to grant the writs, the single question now involved in this case must, with stronger reason, similarly influence the Court.

6. The single question to which the consideration of the Court in this case may be limited, if it shall please this Court to grant its writ of certiorari, involves a variant or another major aspect of the same fundamental question which is presented in the *Special Equipment* case, *i. e.*, the *motive* of a patent owner and the use to which he intends to put his invention and patent. In the *Special Equipment* case, the variant is concerned with a lack of intention to use; in this case, the variant is concerned with actual intended use and the degree of control over competition which the patentee intends to exert.

7. If the question involved in the case at bar is decided according to petitioner's views, this Court will accomplish a complete practical settlement of the fundamental and related questions of patent law involved in this and the *Special Equipment* and *Hoover* cases.

Where cases have presented related questions of law this Court has frequently issued its writ of certiorari to review all of them in order to secure uniformity of decision and practice. *Fashion Originators' Guild v. Federal Trade Commission*, 312 U. S. 457, and *Millinery Creator's Guild, Inc. v. Federal Trade Commission*, 312 U. S. 469; *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U. S. 159, and *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175; *McCandless v. Furlaud*, 292 U. S. 617,

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<sup>1</sup> No. 469 of this term, which was argued on March 2, 5, 1945.

<sup>2</sup> No. 486 of this term, which was argued on March 5, 1945.

*Id.*, 293 U. S. 67, and *Mitchell v. Maurer*, 293 U. S. 237, 544<sup>3</sup>

The case at bar is one of a group of appeals lately pending in the United States Court of Appeals for the District of Columbia which had been taken to that Court in actions brought in the United States District Court of that district pursuant to the provisions of Section 4915 R. S. which confers upon persons seeking patents the right to secure in a court of equity an independent judicial review of the action of the United States Patent Office in refusing a patent to them. In addition to the case at bar, these cases were:

*Special Equipment Co. v. Coe* (App. D. C.), 144 F. (2d) 497.

*Hoover Company v. Coe* (App. D. C.), 144 F. (2d) 514.

*Colgate-Palmolive Peet Co. v. Coe* (App. D. C.), 144 F. (2d) 517.

*Line Material Co. v. Coe* (App. D. C.), 144 F. (2d) 518.

*Monsanto Chemical Company v. Coe* (App. D. C.), 145 F. (2d) 18.

Apparently regarding this group of cases as suitable media for the introduction of wholly novel statutory constructions and doctrinaire reforms, the Court below, in affirming the decrees of the District Court, took advantage of the occasion to announce these important rulings:

(a) In *Hoover Company v. Coe*; *Colgate-Palmolive Peet*

<sup>3</sup> This Court's practice where the cases involve points identical with, or variants of, questions already before the Court is further illustrated by *General Motors Acceptance Corp. v. United States*, 286 U. S. 49; *United States v. The Ruth Mildred*, 286 U. S. 67; *General Import & Export Co. v. United States*, 286 U. S. 70; *United States v. Commercial Credit Co.*, 286 U. S. 63, and *United States v. Corriveau*, 286 U. S. 530.

*Co. v. Coe*, and *Line Material Co. v. Coe*<sup>4</sup> the Court below, contrary to a practice of long standing, refused to assume jurisdiction of actions under Section 4915 where the applicants, desiring to contest interferences with previously granted unexpired patents, had copied claims from those patents and were seeking an independent judicial review by the Federal Courts of the action of the Patent Office in holding that the applicants did not have the right to make the copied claims.<sup>5</sup>

(b) In *Special Equipment Company v. Coe*, the Court below held that patent claims should be denied to a patent applicant on the ground that where there was a lack of intention on the part of the applicant to use the claimed structure which was a novel part of the whole machine, the issuance of a patent therefor would constitute a misuse of the statutory patent privilege; and

(c) In *Monsanto Chemical Company v. Coe* and in *this case*, the Court below held that patent claims may be withheld from an applicant when he has not furnished evidence as to the degree of industrial control which he hopes to gain by means of his claims "over competing industry and competing invention," *e.g.*, the probable economic impact of the patent, if granted, upon a particular industry.

Each of these rulings was unprecedented. Each was without statutory warrant and each was in conflict with well established applicable decisions of this Court. It is difficult to perceive that the first and second rulings or either of them can be more important than the third ruling.

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<sup>4</sup> The Petition for a Writ of Certiorari in the *Line* case (No. 665 of this term) was filed on November 11, 1944, but no disposition thereof has been made.

<sup>5</sup> Petitioner's counsel understand that in his brief, and on the oral argument in this Court, the respondent, in the *Hoover* case, confessed the error of this ruling.

Referring to the *Special Equipment* and *Monsanto* decisions,<sup>6</sup> as the "Arnold opinions," the Honorable V. I. Richard, a member of the Board of Appeals, United States Patent Office, has called attention to the "considerable comment"<sup>7</sup> aroused by the opinions in this "series of cases . . . because of the novelty of their approach to the patent questions considered." *Journal of the Patent Office Society*, Vol. XXVII, pp. 28-30. Although Mr. Richard stated that these decisions "merely affirmed the District Court for refusing a patent and thereby affirming the Patent Office," he admitted, and very significantly observed, that "It was the reasoning in the opinions that was startling."<sup>8</sup>

If, as seems to be inevitable because of the confession of error in the *Hoover* case, this Court shall reverse the Court below in that case, a full and complete settlement of the jurisdictional, substantive and procedural questions, governing actions under Section 4915 R. S., will not be accomplished unless certiorari is granted in the case at bar. Applicants for patents will still be required to submit to and comply with the *Monsanto* rule adopted by the Court below, and they will be required to supply evidence in the light of the industrial facts (adduced from their competitors) as to the "amount of control that should be

<sup>6</sup> Together with *Potts v. Coe* (App. D. C.), 140 F. (2d) 470, with which we are not here concerned.

<sup>7</sup> See for example: "The Slamming of the 4915 Door." *Journal of the Patent Office Society*, Vol. XXVI, pp. 651-663.

<sup>8</sup> The "new approach" reported by Mr. Richard as permeating all of the opinions is: ". . . applications belonging to corporations were appraised from the standpoint of what effect the grant of a patent would have in strengthening the position of its corporate owner in a competitive field. Superimposed on the questions ordinarily considered was the paramount question: Could a patent be misused if it were granted?"

On the other hand, as pointed out by Mr. Richard, the Court of Customs and Patent Appeals has refused to assume that there is a "new doctrinal trend" as to the standards of patents, holding that "the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation." *In re Shortell* (C. C. P. A. April 4, 1944), 142 F. (2d) 292, 296.

allowed to the inventor as his reward," before being entitled to their patents. If that rule is erroneous, as we have shown it to be in our petition for rehearing, then, obviously, a reversal of the *Hoover* case only, will not provide full and adequate relief.

Nothing in a practical or realistic sense will be settled by a holding that the Court below has jurisdiction when that Court is left with its decision in the *Monsanto* case which is the full equivalent of the right to decline jurisdiction. That decision will continue to be controlling in the Court below unless reviewed and reversed by this Court. This is plainly shown by the recent invocation and application of the questioned rule in *F. J. Stokes Mach. Co. v. Coe* (App. D. C., decided Jan. 22, 1945), 64 U. S. P. Q. 203.

Hence, the doctrine here involved is equally as important as those involved in the *Hoover* and *Special Equipment* cases. In order to secure a review by this Court of all of the rulings, adversely affecting the constitutional and statutory rights of inventors, which have been made by the Court of Appeals for the District of Columbia, it is urgent that certiorari be granted in this case.

### CONCLUSION.

The main claims here in question are already extant in the patent of another and later applicant, and enjoy a strong presumption of validity. Petitioner which practices the invention in the manufacture of large quantities of the special colored coated granules is nevertheless being denied its right to contest priority. It has no adequate remedy save through the writ here sought. Even the right to a declaratory judgment (which would not, however, be an adequate remedy) does not exist.

Counsel recognize that this Court should not be burdened with ordinary cases, and they are aware also that it is presumptuous to seek certiorari, especially by a second petition for rehearing, unless there are present questions of a fundamental nature and of great moment requiring the exercise by this Court of its supervisory power of review. It is felt that such a question is present and that this second petition is justified in asking this Court to reconsider its denial of the first petition for rehearing<sup>9</sup> and upon such reconsideration vacating the order denying the petition for a writ of certiorari and awarding the writ.

Respectfully submitted,

J. BERNHARD THIESS,  
SIDNEY NEUMAN,  
HAROLD J. KINNEY,  
*Counsel for Petitioner.*

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<sup>9</sup> In addition to the authority of *Cleveland Trust Co. v. Scriber-Schroth Co.*, cited in the motion, ante p. 3, see *Massey v. United States*, 291 U. S. 608, 655-6, where the writ was granted upon petition for rehearing and consideration limited to the question raised by that petition. Cf. also *Brinkerhoff-Paris Co. v. Hill*, 280 U. S. 550, and *Exhibit Supply Co. v. Ace Patents Corp.*, 314 U. S. 702.

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### CERTIFICATE OF COUNSEL.

The undersigned counsel for petitioner hereby certifies that the foregoing second petition for rehearing is presented in good faith and not for delay.

J. BERNHARD THIESS.

